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IN THE

Supreme Court of the United States

October Term, 1955

No._____

CHARLES F. RUBSAM,
Petitioner

vs.

HARLEY C. LONEY COMPANY,
Respondent

Petition for a Writ of Certiorari
to the United States Court of Appeals
for the Sixth Circuit

Petitioner, Charles F. Rubsam, prays that a writ of certiorari issue to review a judgment of the United States Court of Appeals for the Sixth Circuit entered December 20, 1954 (App. 16) and with respect to which a petition for rehearing was denied April 5, 1955.*

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* References marked "R" are to the pages of the transcript of the record in the court below, filed with the Clerk pursuant to Rule 21 (1) of the Rules of this Court; nine additional copies of the record have been filed pursuant to Rule 21 (4). References marked "App." are to the Appendix of this petition. References to the 11 documents contained in the record are marked "R. Document" with the number thereof.

OPINIONS BELOW

The opinion of the District Court (R.44 - 60) reported in 117 F. Supp. 164, is not printed in the Appendix hereto because nine copies of the record have been filed under Rule 21 (4).

The opinion of the Court of Appeals is reported in 217 F. 2d 353 and is printed in the Appendix hereto, pp. 16-18.

JURISDICTION

The judgment of the Court of Appeals was entered December 20, 1954 (App. 16). A timely petition for rehearing was denied on April 5, 1955 (R. Document No. 11). The jurisdiction of this Court is invoked under 28 U.S.C. 1254 (1).

QUESTIONS PRESENTED

1. In an action on a patent license contract conveying exclusive rights under various United States patents, can the Federal Courts void such property rights by singling out one specific patent, ignore the others and dismiss the action on the ground that exclusiveness did not prevail?

2. In an action on a patent license contract under various United States patents, can the Federal Courts ignore the invalidity of the most important patent and dismiss the action on the ground that said patent was valid and in effect?

3. Can a Court of Appeals ignore the facts upon which Petitioner based his appeal and render a *per curiam* decision based on facts which were not involved in the appeal?

4. In an action on a patent license contract conveying rights under various license agreements superseding each other and covering the territory of the United States, can the Federal Courts dismiss the action by singling out an initial agreement and ignore the fact that it was subsequently cancelled and terminated and disregard the effect of all subsequent and superseding agreements?

CONSTITUTIONAL PROVISIONS INVOLVED

The pertinent provisions of the Fifth Amendment to the Constitution of the United States provide:

> " . . . nor shall any person . . . be deprived of life, liberty or property, without due process of law; . . ."

STATEMENT

This cause concerns an action of law involving various patent license agreements, in connection with an initially cancelled contract, and covering five patents owned by Respondent one of which was declared invalid in July 1947. These patents are in evidence, and copies appear in record following page 142, as follows:

Hume 2036757 Appl. Ser. No. 645,504.....Ex. E-2
Hume 2122065 .....Ex. E-3
DuSang 2029561 .....Ex. E-1
Hatch 2173321 .....Ex. BBB
Kalajian 2314145 .....Ex. BBB

Of these, the DuSang patent No. 2029561 must be excluded because its claim 1 covering the construction of casting a balance weight onto a spring clip was held invalid by the courts wherefore this invention became public property after July 23, 1947. A copy of the DuSang patent Ex. E-1 disclaiming the invention covered by its claim 1 is included in the Appendix hereto.

All Loney owned patents relate to spring clip balance weights which are used extensively on automobile wheels to assure safety at high speed.

This petition is filed for securing a correct interpretation of the all-important paragraph 2 of agreement A entered into between Petitioner and Respondent on February 17, 1936. Said paragraph (R. 4 bottom) conveys to Petitioner exclusive manufacturing and selling rights under any and all patents owned by Respondent under the following grant:

> "2. Hume and Loney hereby grant to Rubsam an exclusive license under United States patent to issue on said application No. 645,504, and/or under any other patent that may issue on any application for letters patent by Hume and/or that may be owned or controlled by Hume or Loney for the life of any and all of said patents, and without royalty payment to manufacture and sell throughout the United States balance weights to automobile manufacturers as standard equipment to be used in balancing wheels at the assembly plant, but not elsewhere, having a resilient spring clip for retaining the weight in position upon the edge of the tire retaining flange of the wheel rim;"

Under this sweeping exclusive license Respondent excluded itself definitely from the automobile production field by conveying to Petitioner the right to use Respondent's patents in that field as if they were owned by him. This is evident from paragraph 2 of the subsequent agreement C, dated August 24, 1936 (R. 9-11), under which Respondent accepted from Petitioner a non-exclusive back-license under its own patents to sell the same spring clip weights for balancing wheels at the factories of General Motors subsidiaries by paying Petitioner a royalty of ½ cent for each weight sold. (See paragraph 2 R. 9 bottom.)

Thus, Respondent recognized without any reservation that Petitioner owned and controlled this production field under said agreement Ex. A in connection with the supplementary agreement Ex. C.

In its decision dated December 20, 1954, the Court of Appeals totally ignored the well defined exclusive patent rights which Petitioner had acquired under all patents owned by Respondent. By disregarding the provisions covered by the agreement Ex. C, the court considered only agreement Ex. A for which it stated as follows, (App. 18, end of first paragraph)

> "That agreement included a license under any other patent that may issue on my application for letters patent by Hume or Loney. *It did not cover additional license rights under the same patent.*"

This action was started in the District Court to recover royalties due after January 1, 1948 on two specific issues, viz. on an express license under the patents owned by Respondent called herein "the Loney patents" which have been listed on foregoing page 3, and on an implied license under patents owned by Petitioner called herein "the Rubsam patents." The District Court treated these two licenses separately and covered said *express license under the Loney patents* in the first 9 pages of its decision (R. 44-52 top). The implied license under the Rubsam patents was covered in another 9 pages (R. 52-60) and was not involved in the appeal. In his petition for rehearing (R. Document No. 6) Petitioner explained on pages 4 and 5 that he agreed with the District Court's finding regarding the Rubsam patents. For this reason, these patents are not here in evidence, being out of the case.

Petitioner clarified this on page 20 of said petition for rehearing as follows.

"However, the 'implied license' is not connnected with this appeal which covers exclusively the 'Express License' which Plaintiff conveyed to Defendant under any and all of its owned or controlled patents. Plaintiff therefore respectfully requests that this Court hand down a supplemental Decision."

This action is accordingly limited to the Express License. The scope of that license involves various patent license contracts superseding each other under the reservation of paragraph 2 of agreement A as follows (R. 5 top):

> ". . . the herein granted license is subject to outstanding licenses entered into between Hume and Chrysler Motor Corporation of Detroit, Michigan, dated December 13, 1932, between Loney and the Nash Motor Company of Kenosha, Wisconsin, bearing date June 29, 1933 and between Hume and Virgil L. DuSang, Kokomo, Indiana, executed December 4, 1934."

The record shows that these 3 licenses were terminated in 1936 and 1938 as follows:

CHRYSLER received from Respondent a paid-up license and Petitioner makes no claim for royalties payable by that company.

NASH royalties were payable directly to Petitioner under the assignment covered by paragraph 4 of agreement Ex. B (R. 7 middle), and Petitioner makes no claim for royalties payable by Respondent on sales to the Nash Motor Company.

The HUME-DUSANG agreement of December 4, 1934 was cancelled and terminated on July 18, 1938 under paragraph 1 of agreement Ex. G, (R. 34-36). It states in its preamble that Hume and DuSang have assigned their patents to the new owners, the Harley C. Loney Co. and the Turner Mfg. Co. who are desirous to cancel the said Hume-DuSang cross license. Paragraph 1 of said agreement G (R. 35 top) states as follows:

> "All other cross-licensing agreements . . . under which the parties Loney and Turner have heretofore operated, are hereby cancelled and terminated."

Following the execution of said agreement G, Respondent paid the ½ cent royalty on each cast-on spring-clip balance weight to Petitioner under the supplementary agreements. The Royalty Reports are in evidence as Plf! Ex. 72 (R. 106-109) and were made under the following heading:

"ROYALTY PAID TO"

> "C. F. Rubsam, Santa Barbara, California, covering amount due as per license agreement on the sale of L&H clip weights to General Motors Corporation units for production purposes only, as entered into by and between C. F. Rubsam and the Harley C. Loney Company under date of August 26, 1936, as well as by Rubsam's and Loney's supplementary agreements of dates thereafter."

Whereas the contract of August 1936, Ex. C (R. 9-11) permitted Respondent to sell spring clip weights only to General Motors subsidiaries, the supplementary agreements referred to in these royalty reports permitted Respondent to extend its sales to numerous additional automobile manufacturers. This is evident from said Ex. 72 which shows sales for the months of November 1946 to May 1947 to the following automobile manufacturers:

Kaiser-Frazer, Studebaker, Federal Motor Truck and Twin Coach Co. Two subsidiaries of the Ford Motor Co. were added later, viz. Lincoln and Mercury as is evident from Respondent's answer to Petitioner's interrogatory No. 10 (R. 113 top).

Despite this overwhelming evidence to the contrary, the District Court and the Court of Appeals denied that additional license rights prevailed.

This action involves U.S. Patent Law as it relates to patent license contracts under Respondent's own patents. While these contracts were in effect, one of these patents, the DuSang patent No. 2029561 which plays a very important role in this action was declared invalid as to claim 1 thereof by the United States Court of Appeals for the Seventh Circuit, "Harley C. Loney Company v. Ravenscroft" 162 F 2d 703 (R. 185-186). That Court affirmed Judge Swigert of the District Court in Hammond, Ind., who had found said patent invalid on Nov. 5, 1945. Petitioner, during cross-examination, testified about this DuSang invalidity after the District Judge questioned him about the date (R. 194 top).

Thus, the District Court was amply informed but decided the action as if the DuSang patent had remained valid. The evidence here includes the disclaimer filed by the owner of the DuSang patent which is printed on page 3 of the patent (Ex. E-1, R. following p. 142) a copy of which is bound at the end of the Appendix to this petition.

This action was brought in the District Court under 28 U.S.C. 1332, Petitioner being a resident of California, Respondent being a Michigan Corporation and the matter in controversy exceeding the sum of $3,000, exclusive

of interest and costs. The District Court denied Petitioner any relief. It held (R. 51-52) that the exclusive license granted by Respondent to Petitioner by agreement A (R. 4-5) did not include cast-on spring-clip weights because of the Hume-DuSang agreement of December 4, 1934 (Ex. 1, R. 21-24). In so holding, the District Court overlooked or ignored:

(a) the fact that the Hume-DuSang agreement was cancelled and terminated by a subsequent agreement of July 18, 1938 (Ex. G, R. 34-36);

(b) the invalidity and disclaimer of claim 1 of the DuSang patent 2029561 covering cast-on spring-clip weights, erroneously stating in this connection that questions of invalidity of patents are not involved.

The Court of Appeals affirmed in a *per curiam* opinion (App. 16). In so doing that Court:

(a) erroneously quoted from paragraph 2 of agreement Ex. A, that

"IT DID NOT COVER ADDITIONAL LICENSE RIGHTS UNDER THE SAME PATENT,"

thereby depriving Petitioner of his exclusive license rights under any and all patents owned by Respondent.

(b) did not consider the invalidity of claim 1 of the DuSang patent 2029561 and

(c) erroneously considered the implied license issue under the "Rubsam patents" which was not involved in the appeal.

Under U.S. Patent Law the filing of a disclaimer terminates the scope of the patent and any contract involving such a patent is void and no longer binding. In an action involving patent license contracts it is mandatory for the court to rule on the scope of patents. When several patents are involved, it is just as important to rule on the limited scope of an invalid patent as on the scope of patents which are still running as is the case with two of Respondent's patents, viz. the Hume Pat. No. 2122065 expiring June 28, 1955 and the Kalajian Pat. No. 2314145 expiring March 16, 1960.

In "Motor Wheel Corporation vs. Rubsam Corporation" *supra,* the Court of Appeals for the Sixth Circuit states on page 3 of the opinion (R. Document No. 9):

> "The interpretation of a patent is a question of law for the Court;" also
>
> "In a royalty case the contract is limited by the scope of the patents, and the Court must construe them."

Despite all evidence concerning "invalidity" of claim 1 of DuSang patent 2029561, the District Court ignored it by stating for the express license as follows (R. 44 middle):

> "Questions of validity, invalidity or infringement of patents are not involved."

It is obvious that the District Court erred when concluding its Judgment (R. 52 top) with the words:

> "Rubsam was subject to the exclusive license granted by Hume to DuSang on Dec. 4, 1934."
>
> No one could be held subject to an agreement which was based on an invalid patent.

During the oral argument before the Court of Appeals on December 2, 1954 Petitioner explained the invalidity of the cast-on invention by showing to the Judges the Official Gazette issued by the U.S. Patent Office on August 26, 1947 and read the disclaimer of claim 1 of the DuSang patent printed on page 527 (R. Document No. 10). Petitioner's letter of February 14, 1955 (R. Document No. 8) explains the pleadings during said oral argument by Petitioner as follows:

> "... I recall very distinctly that I discussed during the oral argument *patent law in connection with contract law* which governs my suit against the Harley C. Loney Co. I made particular reference to the invalidity of the DuSang patent No. 2029561 as covered by its disclaimer filed July 13, 1947 and showed your Court the Official Gazette of August 26, 1947 in which it was published. Under patent law, this official publication gave notice to everyone in the U.S.A. that the DuSang "cast-on" invention had become public property and that everybody could use it.
>
> "Now, this invalidity was discussed in my reply brief from page 8 top to page 9 middle under the following headings:
>
> 'The DuSang Patent was declared finally invalid in 1947.'
>
> 'The Ooms opinion ignores the DuSang invalidity.'
>
> but your Court did not refer to it in its opinion."

Thus, the Court of Appeals had all the evidence concerning "invalidity" before it when it denied rehearing (R. Document No. 11). The Court should have provided to decide the effect of that invalidity.

In the Judgment rendered December 20, 1954, the Court of Appeals stated that "this cause came on to be heard on the transcript of the record". . . (App. 16) It would lengthen this outline considerably if Petitioner would discuss all the additional evidence available from the transcript. However, two letter-exhibits so drastically conflict with the opinions of the Disrict Court and of the Court of Appeals that it becomes vital to quote from them as follows:

Plf! Ex. PP is a letter written by Respondent's Patent Attorney Beaman to General Motors Corporation (R. 90-95) dated Nov. 29, 1947 which was 5 months after the DuSang disclaimer was published in the Offical Gazette of the U.S. Patent Office. The said letter refers to this invalidity as follows (R. 92 top):

> "In arriving at the opinion of no invention in the Seventh Circuit, there was an assumption of independent development by DuSang . . . based upon applications filed in 1934."

The letter then refers to paragraph 2 of agreement C (R. 9 bottom) which is the back license covering General Motors, and states:

> "The established royalty rate is a half cent per weight. The Loney Company is obligated to pay this royalty on all weights that it manufactures and sells for use on the production line of the spring clip type." (R. 93 bottom 94 top)

A copy of said letter was mailed to Respondent (R. 95 middle) who wrote Petitioner on following December 16, 1947 as follows (Ex. RR, R. 96 middle):

> "The Loney Company has not altered its stand . . . and we expect to continue to pay royalties on production business until such time as our Patents are declared invalid in the Sixth Circuit."

ARGUMENT

The decision of the Court of Appeals is so grossly erroneous in important respects as to call for an exercise of the Court's power of supervision.

The questions presented are of vital importance to the parties of a patent license contract. There is scarcely a manufacturer in the United States which is not operating under one or more patent license contracts. Practically every invention of any consequence which is patented in the United States is the subject matter of one or more license contracts.

If the decisions in the District Court and the Court of Appeals are permitted to stand, there will be a lack of uniformity with respect to this important question of Patent Law which will produce confusion and uncertainty for both manufacturers and patent owners throughout the Nation.

The rule representing the weight of authority on these questions is best stated in Victory Bottle Capping Mach. Co. vs. C & J Mach. Co., 280 Fed. 753, 758, as follows:

> "It is a maxim of Common Law that one granting a thing impliedly grants that without which the thing expressly granted would be useless to the grantee. This maxim is as applicable to grants of patent rights as to other species of property" . . .

Patent Rights are Property Rights when made exclusive, and Property Rights are guaranteed by the Constitution of the United States. In its preamble it provides for a more perfect Union to establish Justice etc. and the Fifth Amendment provides that no person shall be deprived of property without due process of Law. The Fifth Amendment implies that the people retain the right to petition the Government for redress of grievances and was obviously provided because the people look to the Government as the Guardian of its Property Rights. These rights cannot be taken from the people without due process of law and Petitioner respectfully submits that his property rights be re-instated on the following ground:

(a) In deciding that an invalid patent was in effect, the District Court and the Court of Appeals swept aside the provisions under U.S. Patent Law that invalidity terminates the scope of a patent. Simultaneously, the District Court and the Court of Appeals swept aside Petitioner's Property rights.

(b) In deciding that Petitioner's royalty is not payable on the "Rubsam patents" the Court of Appeals based its decision on a question not presented. As pointed out before, the appeal in this action does not concern the Rubsam patents but 5 patents owned by Respondent.

(c) In deciding that the contracts "did not cover additional license rights under the same patent," the Court of Appeals swept aside Petitioner's *exclusive license* under any and all patents owned by Respondent which conflicts with contract law and patent law.

(d) In deciding that Petitioner's contract rights were subject to the cancelled and terminated Hume-DuSang agreement (Ex. 1, R. 21-24) the District Court and the Court of Appeals decided that a void contract was in effect. This conflicts with Petitioner's property rights which he acquired under superseding agreements.

CONCLUSION

The Evidence supported by letter-exhibits PP and RR (explained on previous page 12 of this brief) shows that Respondent was informed by Patent Counsel that the DuSang patent No 2029561 was invalid wherefore the Hume-DuSang agreement of Dec. 4, 1934 had become void. Respondent was in full agreement with Petitioner as late as December 16, 1947 that his royalty was due on all spring clip cast-on balance weights sold to automobile manufacturers under all the other valid patents.

For this reason, Respondent must furnish to Petitioner the required monthly Royalty Reports under the identical heading as shown on page 7 of this brief.

The royalty of ½ cent per weight is due on all direct and indirect sales by Respondent to automobile manufacturers starting January 1st, 1948, and Respondent owes compound interest at the legal rate starting from the month and year when due.

For the reasons stated, it is respectfully submitted that this petition for a writ of certiorari should be granted.

CHARLES F. RUBSAM

Pro Se

June 1955

JUDGMENT

(Filed December 20, 1954)

Appeal from the District Court of the United States for the Eastern District of Michigan.

This cause came on to be heard on the transcript of the record from the District Court of the United States for the Eastern District of Michigan, and was argued by counsel.

On consideration whereof, it is now here ordered and adjudged by this Court that the judgment of the said District Court in this cause be and the same is hereby affirmed.

OPINION

(Filed December 20, 1954)

No. 12154

UNITED STATES COURT OF APPEALS

For the Sixth Circuit

Charles F. Rubsam, *Appellant,* v. Harley C. Loney Company, *Appellee.*	Appeal from the United States District Court for the Eastern District of Michigan, Southern Division.

Decided December 20, 1954

Before Martin, McAllister and Miller, Circuit Judges.

Per Curiam. Appellant, Charles F. Rubsam, by this action seeks an injunction against the appellee, Harley C. Loney Company, hereinafter referred to as Loney, against further infringement of appellant's patent rights and an accounting for profits and damages for past infringement. The District Judge, including findings of

fact in his well-developed opinion, as authorized by Rule 52(a), Rules of Civil Procedure, dismissed the action, from which ruling this appeal was taken. See 117 Fed. Supp. 164.

Appellee is the assignee of Hume Patent No. 2-036,757 granted April 7, 1936, dealing with balancing weights used in balancing wheels on automobiles. Appellant claims to have acquired the exclusive right to manufacture and sell wheel balance weights in the production field under said patents by means of license agreements executed February 17, 1936, while said patents were still in the application stage. These rights are set out in written agreements of that date, filed as Exhibits A and B. The rights of the respective parties were also affected by an agreement of August 24, 1936, filed as Exhibit C, and by an alleged agreement dated August 5, 1944, filed as Exhibit D, the making of which was denied by the apppellee. Appellant's rights are determined by the terms of these written instruments and by the determination of whether Exhibit D ever became an executed contract between the parties.

As pointed out by the District Judge, at the time when Exhibits A and B were executed the license thereby granted to Rubsam was subject to outstanding licenses entered into between Hume and each of the following, namely, Chrysler, Nash and DuSang. Exhibit A expressly provides that the license being granted to Rubsam was subject to those outstanding licenses. We agree with his ruling that the provision in relation to cast-on spring clip weights in the exclusive license given by Hume to DuSang was at no subsequent time divorced from the Hume-Dusang license and given over to Rub-

sam. It is true that in Exhibit A Hume and Loney agreed that the royalty rate provided in the license agreement between Hume and DuSang would not be decreased without the consent of Rubsam, and that this provision was possibly, though not without question, violated by the rewriting of the Hume-DuSang agreement on July 18, 1938 in a compromise of some pending infringement proceedings in the District Court at Indianapolis, Indiana which new agreement contained royalty-free cross licenses. Rubsam is not suing for damages arising out of that alleged breach. Any new rights acquired by Loney through this agreement did not pass to Rubsam through the medium of the original license agreement, Exhibit A, as contended by Rubsam. That agreement included a license 'under any other patent that may issue on my application for letters patent by Hume or Loney." It did not cover additional license rights under the same patent.

The District Judge made findings that there was neither an express nor an implied license on the Rubsam patents in service to Loney, under which Loney would be required to pay the royalties claimed by Rubsam, and that the alleged contract of August 5, 1944, Exhibit D, under which Rubsam claims that Loney had an express license under the Rubsam patents for original production was merely a written offer from Loney which was not accepted by Rubsam and did not mature into a contract between the parties. These findings are supported by the evidence, which is well reviewed in the District Judge's opinion, to which reference is made, are not clearly erroneous, and are accepted on this appeal.

The judgment is affirmed.

Feb. 4, 1936. V. L. DU SANG 2,029,561

WHEEL BALANCING WEIGHT

Filed April 4, 1934

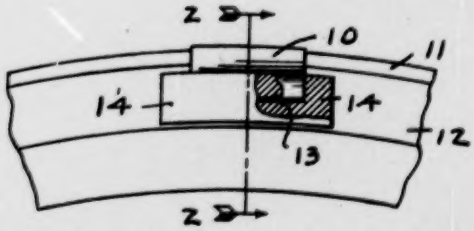


Fig. 1.

Fig. 2.

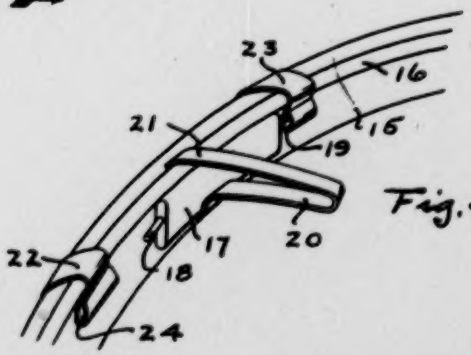
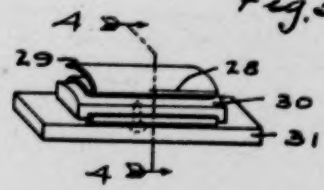


Fig. 5.

Fig. 3.



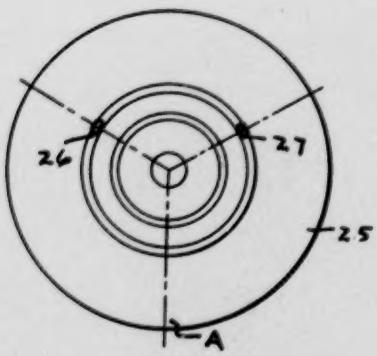


Fig. 6.

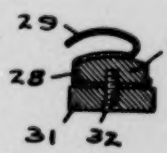


Fig. 4.

Inventor,
Virgil L. DuSang,
By
Minturn & Minturn,
Attorneys.

UNITED STATES PATENT OFFICE

2,029,561

WHEEL BALANCING WEIGHT

Virgil L. Du Sang, Kokomo, Ind.

Application April 4, 1934, Serial No. 718,915

3 Claims. (Cl. 301—5)

This invention relates to the art of balancing weights to be applied to rotating members particularly in automobile wheels. With the advent of high speed performance of automobiles and tires of considerable relative weight with large diameters, difficulty is frequently encountered in keeping the automobile traveling in a straight line. When a tire or a wheel on which the tire is mounted, or both, may be out of balance, the unbalanced condition of that wheel will cause the tire to tend to crawl causing one wheel to advance faster than the other so as to produce a turning effect particularly with the front wheels although the same effect may be observed with the rear wheels. It has been observed that in some cases the tires or the wheels may be so much out of balance that at speeds of 50 miles per hour or above, the unbalanced effect will be sufficient to cause the wheel to actually leave the ground during part of its revolution.

I am aware of the fact that weights have been employed to counteract the unbalanced effect, but considerable difficulty has been had with such known types of weights for this purpose in that the weights could not be applied easily to the wheel and when applied would lose off.

It is a primary purpose of my invention to provide a quickly attachable weight which will be safe and also very easily applied. It is a further primary object of my invention to provide such a weight attaching means as will permit the weight to grip the rim of a wheel with the tire thereon cooperating to retain the weight in place.

Other advantages and objects of the invention will become apparent to those versed in the art in the following description, with reference being made to the accompanying drawing, in which

Fig. 1 is a fragmentary side elevation of a tire rim to which my invention is applied;

Fig. 2, a vertical section on the line 2—2 in Fig. 1;

Fig. 3, a view in perspective of a modified form of the invention;

Fig. 4, a section on the line 4—4 in Fig. 3;

Fig. 5, a view in perspective of a still further modified form of the invention; and

Fig. 6, a side elevation of a wheel indicating the relative locations of weights.

Like characters of reference indicate like parts throughout the several views in the drawing.

Referring first to the form of the invention as shown in Figs. 1 and 2, I provide a spring steel metallic clip 10 substantially S-shape in cross section and having the upper loop thereof formed to fit snugly about the outer peripheral edge 11 of a tire rim 12. This upper loop is so formed that it will yieldingly grip over the edge 11 and will have to be driven in place. The lower outer end of the clip 10 is turned outwardly and is preferably cut to have barbs 13 along its outer edge. A mass of lead 14 is carried by the lower leg of the clip 10, being molded in place thereon so that the barbs 13 will prevent the lead from slipping thereoff. The lead 14 is molded so as to fit snugly around the lower portion of the clip 10 as best indicated in Fig. 2 and the outer face of the lead 14 preferably terminates in a vertical plane not beyond the outer portion of the clip 10. It is thus to be seen that the mass of lead 14 is carried snugly back under the outturned edge 11 of the tire rim so that under centrifugal force, the lead 14 tends to bear upwardly against the clip 10 which in turn bears against the under side of the outturned edge 11. With the mass of the lead carried back under the edge 11, there is no tendency for the lead to loosen up and fly off of the clip 10.

It is to be understood that this mass of lead 14 may vary in weight depending upon the weight required to correct the unbalanced condition of the wheel. In practice I supply these weights with the mass of lead 14 varying through a range of several ounces. It is to be noted that the upper inturned lip of the clip 10 passes well down over the top side of the edge 11 of the rim so that the tire carried on the rim will yieldingly grip at least the inner edge of the clip 10 to press it against the rim. These clips 10 may be entered over the edge 11 at any point around the rim 12 and then driven into place to become a fixed part of the wheel. It is understood that the wheel is allowed to revolve on some balancing device in the usual way to locate the heavier side thereof and that the weights are then applied on the opposite side to counteract that unbalanced weight.

In some cases a tire rim is encountered wherein there is but a very slight projection of the peripheral edge, and in this case I provide a weight of the type indicated in Fig. 5 which is flattened in nature to lie back under that slight extending edge. Referring to Fig. 5, the rim 15 has the overhanging edge 16. A weight 17 is formed to have pins 18 and 19 extending from its respective ends. The weight 17 is initially held in place by means of a clip 20 which grips the under side of the weight 17 and urges it up snugly against the under side of the overhanging edge 16 by means of an upper arm 21 which passes over the top of the edge 16. With the weight thus temporarily secured in place, the

wheel is placed on some sensitive balancer and the weight 17 then adjusted circumferentially around the rim until the wheel is brought into balance.

When this position of the weight 17 is determined, a pair of clips 22 and 23 are placed over the edge 13 to have a lower looped portion 24 in each case extending back under the edge 13 to be in compressive contact with the vertical face of the rim 15 thereunder. These clips 22 and 23 are moved circumferentially along the rim to have their looped portions brought up and telescoped over the pins 18 and 19, the clip 23 being herein shown as just engaging the pin 19. After the clips 22 and 23 are thus positioned, the temporary clip 20 is removed. The weight of the clip 20 is made to be equal to the combined weights of the clips 22 and 23 so that the wheel is kept in balance after the clips 22 and 23 are attached to carry the weight 17 in service and after the temporary locating clip 20 has been removed.

It is preferable to use two or more weights on a wheel to overcome an unbalanced condition and such weights should be located in some such manner as indicated in Fig. 6 where the unbalanced portion of the wheel 25 is on the under side such as at A, that is, A indicates the heavier side of the wheel. Since that unbalanced weight may be distributed over an area rather than being located at a point, it is better to divide the weights as above indicated so as to use two or more. In Fig. 6 two such weights are indicated as being employed and they are located, one each a third of the way around from the heavy side A, that is the two weights 26 and 27 are spaced around one from the other 120°, and each is also spaced around from the heavy side 120°. The combined effect of the weights 26 and 27 is made by selecting the proper weight in each case to exactly balance the wheel.

Where it is not desired to employ weights fixed to the clips as in the form shown in Figs. 1 and 2, a type of structure as indicated in Figs. 3 and 4 may be employed wherein the clip 28 has an upper portion 29 adapted to be driven over the edge of the tire rim as in the case of the clip 10. The lower leg of the clip 28, however, is carried around and outwardly to a somewhat greater distance and is shaped to carry a mass of metal 30 between it and the upper portion of the clip. An additional mass of metal 31 is brought up against the under side of the lower leg and a screw 32 is passed through this lower piece of metal and the clip leg and screwthreadedly engaged in the metal 30. Thus by varying the dimensions of the lower metal 31, that is by having these pieces of metal 31 in varying sizes, the weight desired may be had by selecting that particular piece of metal 31 to give that weight. Of course the lower weight 31 may be even dispensed with entirely where the weight of the metal 30 is sufficient.

While I have herein shown and described my invention in the simplest and best forms as now known to me, it is obvious that structural changes may be made, particularly in the manner of securing the mass of metal to the clip, without departing from the spirit of the invention, and I, therefore, do not desire to be limited to those precise forms, nor any more than may be required by the following claims.

I claim:

1. For balancing a wheel having a rim with an edge extending upwardly and outwardly, the combination of a weight shaped to be confined substantially under the projection of said edge, and a clip carrying the weight and compressibly engaging over the edge to extend around and downwardly on the inner side thereof, said clip being made out of spring steel, and said weight being cast over a barbed foot of the clip.

2. For balancing a wheel having a rim with an edge extending upwardly and outwardly, the combination of a weight shaped to fit under said edge and against said rim, and a clip carrying the weight and elastically engaging over said edge to extend downwardly on the inner side thereof, a foot out-turned from the lower end of the clip having an opening cut therethrough, and said weight being formed around said foot and through said opening as a means of securing the weight to said clip.

3. For balancing a wheel having a rim with an edge extending upwardly and outwardly, the combination of a weight shaped to fit under said edge and against said rim, and a clip carrying the weight and elastically engaging over said edge to extend downwardly on the inner side thereof, a foot out-turned from the lower end of the clip having an opening cut therethrough, and said weight being formed around said foot and through said opening as a means of securing the weight to said clip, said clip being substantially S-shaped to carry around from said embedded foot over the weight and thence over said edge.

VIRGIL L. DU SANG.

DISCLAIMER

2,029,561.—*Virgil L. Du Sang*, Kokomo, Ind. WHEEL BALANCING WEIGHT. Patent dated Feb. 4, 1936. Disclaimer filed July 23, 1947, by the assignee, *Turner Manufacturing Company*.

Hereby disclaims claim 1 of said patent.

[*Official Gazette August 26, 1947.*]

DISCLAIMER

2,029,561.—*Virgil L. Du Sang*, Kokomo, Ind. WHEEL BALANCING WEIGHT. Patent dated Feb. 4, 1936. Disclaimer filed July 23, 1947, by the assignee, *Turner Manufacturing Company*.

Hereby disclaims claim 1 of said patent.

[*Official Gazette August 26, 1947.*]

CERTIFICATE OF CORRECTION.

Patent No. 2,029,561. February 4, 1936.

VIRGIL L. DU SANG.

It is hereby certified that error appears in the above numbered patent requiring correction as follows: Page 2, end of specification, signature of patentee, for "Virgin L. Du Sang" read Virgil L. Du Sang; and that the said Letters Patent should be read with this correction therein that the same may conform to the record of the case in the Patent Office.

Signed and sealed this 7th day April, A. D. 1936.

Leslie Frazer

(Seal) Acting Commissioner of Patents.

Office - Supreme Court, U. S.
FILED
JUL 28 1955
HAROLD B. WILLEY, Clerk

IN THE

Supreme Court of the United States

OCTOBER TERM, 1955.

No. 190

CHARLES F. RUBSAM,
Petitioner,

vs.

HARLEY C. LONEY COMPANY,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO THE PETITION FOR A WRIT OF CERTIORARI.

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THE BLAKELY PRINTING COMPANY, CHICAGO

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"A court of law, such as this Court is, rather than a court for correction of errors in fact finding, cannot undertake to review concurrent findings of fact by two courts below in the absence of a very obvious and exceptional showing of error."

Mr. Justice Jackson, in *Graver v. Linde* (1949), 336 U. S. 271, 275.

IN THE

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OCTOBER TERM, 1955.

No. 190.

CHARLES F. RUBSAM,

Petitioner,

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HARLEY C. LONEY COMPANY,

Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO THE PETITION FOR A WRIT OF CERTIORARI.

STATEMENT OF THE CASE.

The Petition for Writ of Certiorari admittedly (Pet. p. 4) seeks an "interpretation" of a single paragraph of a contract between the parties. It admits (Pet. p. 8) that the District Court was "amply informed," at least as to some matters. It seeks review of fact questions (Pet. p. 9) which the District Court "overlooked or ignored."

The Petition presents no grounds for review by this Court. None of the requirements governing review on Certiorari, found in Rule 19, is present here. None of the considerations expressed in, or which come within the contemplation of, Rule 19 is present.

While the Petition purports to comply with the requirements of Rule 40, its selective presentation of only part

of the facts obscures the issues on which both lower courts refused Petitioner's claim. Because of this confusion Respondent has found it necessary to state the case rather fully.

This Contract Case Between Private Litigants Is Without Significance to the Public or the Law.

This case concern a patent license—a private contract involving automobile wheel balance weights. Most of the patents referred to in the license have expired (R. 143). The patented device was invented over twenty years ago. It includes a weighted body portion and some means for securing that weighted body portion to the tire-retaining rim flange of an automobile wheel. These devices are employed at the factory to balance the automobile wheel and tire which it bears. Sales of the weights for this purpose to automobile manufacturers are in the "production" field. Wheels not balanced at the factory are balanced by garage men or service station operators. Sales of the weights for this purpose are in the "service" field (R. 45).

The controlling question in the present controversy is whether Respondent owes royalties to Petitioner at the rate of one-half cent per balance weight for all balance weights sold by Respondent in the production field since January 1, 1948 under a contract expressed in four documents (Pl. Ex. A, R. 4; Pl. Ex. B, R. 6; Pl. Ex. C, R. 9; Def. Ex. 1, R. 21). To reach their concurrent conclusions that Respondent does not owe such royalties, the District Court considered several hundred pages of testimony and several hundred documents, and the Court of Appeals reviewed the Record as presented with the Petition. The conclusions reached by the District Court were affirmed (217 F. 2d 353) after a full hearing on appeal by the

Court of Appeals for the Sixth Circuit. Petitioner sought by Petition for Rehearing below to obtain a further review of the facts. The Court of Appeals denied that petition.

The District Court Opinion Presents a Finely Distilled View of the Facts Petitioner Seeks to Have Reviewed.

District Judge Thornton has written a most cogent opinion summarizing the facts (R. 44). Significantly Judge Thornton did not cite a single authority in support of any proposition of law mentioned in his opinion. This was because the case turns—not on rules of contract law, but—on the unique and complex facts which fill this record.

Only the first half of Judge Thornton's Opinion (117 F. S. 164-174, R. 44-60) is concerned with the alleged issues of the present Petition. The remainder of the Opinion is addressed to issues which have been jettisoned by Petitioner.

The Contract Under Which Petitioner Claims Is Bounded by Readily Ascertainable Exceptions Which Are Clearly Stated in the Granting Clause.

Judge Thornton's Opinion details (R. 45) how in December, 1932, one Hume (Respondent's assignor) filed a patent application on a wheel balance weight. In the same month he granted a non-exclusive license under that application to Chrysler Corporation (Def. Ex. 25, R. 151a). Approximately six months later he granted a non-exclusive license to Nash Motor Company (Def. Ex. 26, R. 156a).

Some time later, Hume's application was thrown into interference with an application filed in the name of one DuSang. On December 12, 1934, Hume and DuSang settled that interference by means of a written contract (Def.

Ex. 1, R. 21). That contract provides for several grants between the parties. In Paragraph 3,

> "* * * Hume licensed DuSang *exclusively* to manufacture a spring clip cast-on weight for either production or service at a set royalty, and by granting this exclusive license for the cast-on weight, Hume deeded away from his own control any right to make or sell the cast-on type of weight." (Judge Thornton, 117 F. S. 164 at 167, R. 46-7.) (Emphasis supplied.)

That granting paragraph does not appear in the Petition. It is the clue to the later exchange of rights between Petitioner and Respondent in 1936, and is the basis for the decisions of the District Court and the Court of Appeals. In words, it provides as follows (R. 23):

> "3. First party [Hume] hereby grants to second party [Du Sang], his heirs and assigns, subject to the provisions herein set out, an exclusive license throughout the United States without restriction as to original equipment, or jobbing or direct to user sales, for the life of the patent and/or patents that may issue to first party [Hume] on his aforesaid application Ser. No. 645,504 and/or any other application or applications pertinent thereto, to make, use and sell that specific form of the invention as shown in Figs. 1 and 2 of the drawing in second party's [Du Sang's] application Ser. No. 718,915, namely, a weight having a spring clip attachment portion carrying a weighted body cast upon one portion thereof, and second party shall pay to first party a royalty of one (1¢) cent for each and every weight of this form sold."

Paragraphs 4 and 5 of the Hume-DuSang contract (Def. Ex. 1, R. 21) similarly limit Hume's rights in the cast-on weight field. Those limitations are described by Judge Thornton (117 F. S. 167, R. 47):

"The net effect of paragraphs 3, 4 and 5 was Hume's granting the exclusive rights to the cast-on spring-clip weight to DuSang. Even though, by paragraph 4, Hume obtained a nonexclusive license from DuSang, paragraph 5 prevented his sublicensing to any party who might subsequently obtain rights under the Hume patent, unless the patents were sold outright."

Hume's application was also in interference with an application filed by Petitioner, Rubsam. In February, 1936, Hume, his assignee, the Respondent Loney Company, and the Petitioner Rubsam, settled this second interference by contract (Pl. Ex. A, R. 4; Pl. Ex. B, R. 6). In that settlement Hume granted certain rights to Rubsam. That granting clause is the clause for which Petitioner now seeks an "interpretation" in addition to the concurrent interpretations given it by the District Court and the Court of Appeals.

Judge Thornton quotes the entire paragraph (117 F. S. 167-8, R. 48-9):

"2. Hume and Loney hereby grant to Rubsam an exclusive license under United States patent to issue on said application No. 654,504 and/or under any other patent that may issue on any application for letters patent by Hume and/or that may be owned or controlled by Hume or Loney for the life of any and all of said patents, and without royalty payments, to manufacture and sell throughout the United States balance weights to automobile manufacturers as standard equipment to be used in balancing wheels at the assembly plant, but not elsewhere, having a resilient spring clip for retaining the weight in position upon the edge of the tire retaining flange of the wheel rim; *provided, however, that the herein granted license is subject to outstanding licenses entered into* between Hume and Chrysler Motor Corporation of Detroit, Michigan, dated December 13, 1932, between Loney and the Nash Motor Company of Kenosha, Wisconsin, bearing date June 29, 1933 and *between*

Hume and Virgil L. DuSang, Kokomo, Indiana, executed December 4, 1934; provided, further, that the herein granted license does not extend to balance weights having spring clips sold to automobile manufacturers to be used in service and is specifically restricted to balance weights having a resilient spring clip for holding it in position upon the rim flange as distinguished from the employment of a set screw or other fastening means." (Emphasis added.)

The presentation of this clause in the Petition is less than candid. The broad granting portion appears on page 4. The proviso containing the exception—about which this entire case turns—is belatedly reproduced on page 6.

As pointed out by Judge Thornton, the parties are in substantial agreement as to most of the provisions of Paragraph 2. They are completely in agreement as to the meaning of the exceptions carved out in favor of Chrysler and Nash in the following language:

> "* * * subject to outstanding licenses entered into between Hume and Chrysler Motor Corporation of Detroit, Michigan, dated December 13, 1932, between Loney and the Nash Motor Company of Kenosha, Wisconsin, bearing dated June 29, 1933, * * *."

Petitioner admits (Pet. p. 6) that he is not making any claim for royalties by reason of any change in the Chrysler or Nash agreements.

The disagreement between the parties is as to the effect of the exception carved out to DuSang in the following words:

> "* * * subject to outstanding licenses entered into * * * between Hume and Virgil L. DuSang, Kokomo, Indiana, executed December 4, 1934 * * *."

On February 17, 1936, when Rubsam and Hume signed Pl. Ex. A, DuSang certainly owned the *exclusive* rights to

make the cast-on form of weight. He had obtained this in the contract of December 12, 1934 (Def. Ex. 1, R. 21). As to that form of weight, Hume and Respondent were powerless to grant rights to Rubsam. Therefore no rights were granted to Rubsam to the cast-on weight, by Paragraph 2 of Pl. Ex. A (R. 4). All rights to the cast-on weight were specifically excepted by the language which mentions the earlier Hume-DuSang contract (Def. Ex. 1, R. 21).

Petitioner Claims That the Subsequent Cancellation of the Hume-DuSang Agreement Somehow Vested Rights from DuSang Through Hume-Loney to Rubsam.

On July 18, 1938, an agreement (R. 34) was executed between Turner Mfg. Co. (DuSang's assignee) and Respondent, Loney Company (Hume's assignee). This agreement settled litigation then pending between Turner and a customer of Loney.

In the preamble the parties state (R. 34):

> "WHEREAS it is now the desire of the parties Loney and Turner to settle all pending litigation, and to cancel the original Hume-DuSang cross-licensing agreement under which the parties Loney and Turner have been heretofore operating, and to substitute the following license agreement, and"

The agreement provides in Paragraph 1 (R. 35) that:

> "All other cross-licensing agreements involving the Hume Patent No. 2,036,757, and any and all improvements thereon, under which the parties Loney and Turner have heretofore operated, are hereby cancelled and terminated."

Petitioner asked the District Court to find that this cancellation of the original Hume-DuSang agreement, although unaccompanied by any transaction between Pe-

titioner and Respondent, resulted in a transfer to Rubsam of the exclusive rights given to DuSang in 1934. The District Court refused to make such a finding. Judge Thornton's reaction to this proposition (117 F. S. 169, R. 51-2):

> "* * * to permit the Court to find for the plaintiff in this respect it would be necessary to find that at some time during the dealings between the parties the provision in relation to cast-on spring-clip weights in the exclusive license given by Hume to DuSang was divorced from the Hume-DuSang license and given over to Rubsam. However, the Court can find nothing in the testimony and/or the exhibits that would warrant it in withdrawing cast-on spring-clip weights from the exclusive field in which they were placed by the Hume-DuSang license agreement, and placing them in the control of Rubsam at a subsequent time, and at a time when Rubsam knew, or should have known, that the license granted him by Hume and Loney on February 17, 1936, was subject to the exclusive license granted by Hume to DuSang on December 4, 1934."

Petitioner argued the same point *in extenso* before the Court of Appeals for the Sixth Circuit. That Court likewise refused to find any such transfer of rights. Its Opinion states (217 F. 2d 354, Pet. pp. 16, 17):

> "As pointed out by the District Judge, at the time when Exhibits A and B were executed the license thereby granted to Rubsam was subject to outstanding licenses entered into between Hume and each of the following, namely, Chrysler, Nash and Du Sang. Exhibit A expressly provides that the license being granted to Rubsam was subject to those outstanding licenses. We agree with his ruling that the provision in relation to cast-on spring clip weights in the exclusive license given by Hume to DuSang was at no subsequent time divorced from the Hume-DuSang license and given over to Rubsam. * * * Any new rights acquired by Loney through this agreement did not pass to Rubsam through the medium of the original license agreement, Exhibit A, as contended by Rubsam."

Rubsam now seeks to review the determination by Judge Thornton and the concurring determination by the Court of Appeals for the Sixth Circuit that the cancellation of the Hume-DuSang agreement did not cause rights to pass from DuSang to Rubsam. The intent of the parties clearly expressed in the granting clause in question is fully substantiated by the facts found in the Record reviewed by the District Judge, and again reviewed by the Judges of the Court of Appeals. Petitioner seeks another review of that testimony and those documents to reverse the concurrent Findings of Fact of those lower courts.

ARGUMENT.

The Factual Determinations Made by the District Court and Characterized by the Court of Appeals as Being "Supported by the Evidence" Should Not Be Reviewed Here.

The District Court Opinion (117 F. S. 164) is characterized by the Court of Appeals as being "well-developed" (217 F. 2d 354). Judge Thornton, in the preparation of his Opinion studied several hundred pages of transcript and several hundred documentary exhibits. His analysis of the complicated fact situation, and its ready resolution by elementary legal principles, is emphasized by the fact that his opinion does not contain a single citation to case law authority.

The case is a simple question of contract intrepretation based on unique and complex facts. It is without significance to the public or the law.

The policy of this Court in refusing to review factual determinations in the absence of a clear indication of prejudice and reversible error below has been restated

numerous times recently. In *Allen* v. *Trust Co. of Georgia* (1946), 326 U. S. 630, at 636:

> "Those findings, being concurrent findings of the two lower courts, will be accepted here without re-examination of the evidence."

In *Faulkner* v. *Gibbs*, 338 U. S. 267, we find at 268:

> "We will not disturb the concurrent findings upon the issues presented to us in the Petition for Certiorari."

The classic statement by Mr. Justice Jackson in *Graver* v. *Linde* (1949), 336 U. S. 271, at 275, appears here opposite page 1. That sentence bears repeating:

> "A court of law, such as this Court is, rather than a court for correction of errors in fact finding, cannot undertake to review concurrent findings of fact by two courts below in the absence of a very obvious and exceptional showing of error."

Conclusion.

This case involves special and novel facts and no critical or even interesting questions of law. Both courts below have reached identical findings and conclusions on a voluminous record. This mere contract controversy between two private parties in no way satisfies the requirements for a writ of certiorari as defined in Rule 19.

The Petition should therefore be denied.

Respectfully submitted,

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FILED
AUG 16 1955
HAROLD B. WILLEY, Clerk

IN THE

Supreme Court of the United States

OCTOBER TERM, 1955

No. 190

CHARLES F. RUBSAM,
Petitioner

vs.

HARLEY C. LONEY COMPANY,
Respondent

PETITIONER'S BRIEF IN OPPOSITION TO BRIEF FOR RESPONDENT

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Judge Thornton never considered the "Disclaimer" which is a part of DuSang Patent No 2,029,561, Plf. Ex. E-1, and the Court of Appeals likewise ignored it 2

An assignment of a patent or of an application for patent transfers the entire interest in the patent to the assignee 3

By Assignment Ex. 2, Respondent acquired from Hume all rights under the agreement Def. Ex. 1 3

By Assignment Ex. G, Respondent terminated the original Hume-DuSang exclusive license covered by Def. Ex. 1 3

By Assignment Ex I, Respondent became the owner of the DuSang Patent which brought it under Petitioner's exclusive license covered by paragraph 2 of Contract Ex. A 4

Neither the District Court nor the Court of Appeals considered the Assignments Ex. 2, Ex. G and Ex. I 4

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1955

No. 190

CHARLES F. RUBSAM,

Petitioner

vs.

HARLEY C. LONEY COMPANY,

Respondent

PETITIONER'S BRIEF IN OPPOSITION TO BRIEF FOR RESPONDENT

In opposition to Respondent's contention covered at the outset of its brief, Petitioner seeks an interpretation of important Federal Questions relating to United States Patent Law and to Property Rights under said law. The Rules of Practice of the United States Patent Office are very specific about these questions and are clarified in its pamphlet under the title "General Information concerning Patents," a copy of which is inserted at the end of this brief for the Court's attention. The pamphlet explains the pertinent provisions about which this entire case turns and Petitioner feels that review on writ of certiorari under Rule 19 is therefore amply justified.

THE ORIGINAL HUME-DUSANG EXCLUSIVE LICENSE UNDER DEF. EX. 1 WAS NULLIFIED AFTER THE INVENTION OF CAST-ON WEIGHT WAS DISCLAIMED ON JULY 23, 1947.

Respondent's brief remains silent about this all important question by conveying the impression that this

case is merely a quarrel between Private Litigants without significance to the Public or the Law. The following citations from the Patent Office Pamphlet are the Law:

Page

1 "A patent is granted by the Government acting through the Patent Office."

21 "After the patent has expired, anyone may make, use, or sell the invention without permission of the patentee."

21 "The patentee may disclaim . . . his patent by filing in the Patent Office a disclaimer as provided by the statute."

21 "A patent is personal property and may be sold to others or mortgaged; . . . The patent law provides for the transfer or sale of a patent, or of an application for patent, by an instrument in writing. Such an instrument is referred to as an assignment and may transfer the entire interest in the patent."

22 "A conditional assignment also passes ownership of the patent and is regarded as absolute until cancelled by the parties or by the decree of a competent court."

24 "The protection afforded by a patent does not start until the actual grant of the patent."

Starting out with the last citation on page 24, patent rights prevail only from the date of issue to the date on which the patentee has disclaimed his invention. The citations on page 21 of the pamphlet support this contention.

JUDGE THORNTON NEVER CONSIDERED THE "DISCLAIMER" WHICH IS A PART OF DUSANG PATENT NO 2,029,561, PLF' EX. E-1, AND THE COURT OF APPEALS LIKEWISE IGNORED IT

This disclaimer was published in the Official Gazette of the Patent Office on August 26, 1947 (R. Document No. 10) as follows:

Official Gazette United States Patent Office

Casper W. Ooms, Commissioner

2,029,561.—Virgil L. DuSang, Kokomo, Ind. Wheel Balance Weight. Patent dated Feb. 4, 1936. Disclaimer filed July 23, 1947, by the assignee, Turner Mfg. Co. Hereby disclaims claim 1 of said patent.

AN ASSIGNMENT OF A PATENT OR OF AN APPLICATION FOR PATENT TRANSFERS THE ENTIRE INTEREST IN THE PATENT TO THE ASSIGNEE

Respondent remains silent about the subsequent outright sales by Hume and DuSang to new owners under the assignments which appear on pp 25, 34 and 39 of the record.

BY ASSIGNMENT EX. 2 (DATED JANUARY 5, 1937, R. 25) RESPONDENT ACQUIRED FROM HUME ALL RIGHTS UNDER THE AGREEMENT DEF. EX. 1, as follows:

> I, James W. Hume . . . do transfer all right, title, and interest in the contract held by me with Virgil L. DuSang of Kokomo, Indiana, entered into December 12th, 1934 . . . to the Harley C. Loney Company, a Michigan Corporation . . .

BY ASSIGNMENT EX. G (DATED JULY 18, 1938, R. 34) RESPONDENT TERMINATED THE ORIGINAL HUME-DUSANG EXCLUSIVE LICENSE COVERED BY DEF. EX. 4, as follows:

> WHEREAS, the Harley C. Loney Company of Detroit, Michigan, . . . has acquired by assignment the entire right, title and interest to patent No. 2,036,757, granted to James W. Hume, on April 7, 1936, and whereas the Turner Manufacturing Company of Kokomo, Indiana, . . . has acquired by assignment the entire right, title and interest to patent No. 2,029,561, granted to Virgil

L. DuSang, on February 4, 1936 . . . Loney and Turner have . . . hereby cancelled and terminated . . . the original Hume-DuSang cross-licensing agreement under which the parties Loney and Turner have been heretofore operating . . .

BY ASSIGNMENT EX. I (DATED DECEMBER 17, 1948, R. 39) RESPONDENT BECAME THE OWNER OF THE DU-SANG PATENT WHICH BROUGHT IT UNDER THE PETITIONER'S EXCLUSIVE LICENSE COVERED BY PARAGRAPH 2 OF CONTRACT A, as follows:

Whereas Turner Manufacturing Company of Kokomo, Indiana, is the owner of the U.S. Letters Patent Number 2,029,561 issued to Virgil L. Du-Sang . . . and whereas Harley C. Loney Campany, of Detroit, Michigan, is desirous of acquiring the entire interest in the same:

Now, therefore . . . said Turner Manufacturing Company by these presents, does sell, assign, and transfer unto the said Harley C. Loney Company the entire right, title and interest in and to the said Letters Patent . . .

Respondent points out on page 3 top, that Judge Thornton did not consider rules of law when summarizing the facts covered by his opinion. Under the rules of Patent Law it was mandatory for the District Court to consider the three assignments, Ex. 2, Ex. G and I.

NEITHER THE DISTRICT COURT NOR THE COURT OF APPEALS CONSIDERED THE ASSIGNMENTS EX. 2, X. G, AND EX. I

In failing to mention any of them, Judge Thornton stated erroneously that: *"the Court . . . can find nothing in the testimony and/or the exhibits that would warrant it in withdrawing cast-on spring-clip weights from the exclusive field in which they were placed by the Hume-*

DuSang license agreement, and placing them in the control of Rubsam." . . . (R. 51 bottom 52 top).

Respondent's brief discusses this entire case as if the DuSang "disclaimer" had never been filed and the three assignments, Ex. 2, Ex. G and Ex. I were never executed. The opposite being the case, it becomes useless to reply to Respondent's assertions made under the heading, "Statement of the Case," except for the following: On page 7, Respondent states:

> "Petitioner claims that the subsequent cancellation of the Hume-DuSang agreement somehow vested rights from DuSang through Hume-Loney to Rubsam."
>
> Petitioner rejects this insinuation as no such claim was ever made due to the fact that the said Hume-DuSang agreement became nullified after the invention covering the cast-on type weight was disclaimed, as heretofore clarified.

ARGUMENT

THE EVIDENCE SHOWS THE CONTRARY OF THE DETERMINATIONS MADE BY THE DISTRICT COURT AND BY THE COURT OF APPEALS

Petitioner has submitted the most serious grounds for review in the presence of very exceptional showing of errors. They are in conflict with Patent Law viz. Federal Law as defined by the Government through the Patent Office. None of the three cases cited, *"Allen vs. Trust Co."*, *"Faulkner vs. Gibbs"* and *"Graver Tank & Mfg. Co. Inc. vs. Linde"*, have any resemblance with the present case.

Mr. Justice Jackson's quoted "classic statement" applies here in the reverse because of the presence of a very obvious and exceptional showing of errors in two concurrent findings which are in very serious conflict with the evidence presented.

Both the District Court and the Court of Appeals failed to rule on the scope of the DuSang patent No. 2,029,561 despite the fact that this case turns entirely about its invalidity, supported by Ex. E-1, the copy of the patent in evidence. This deprived petitioner of his Property Rights in violation of the Constitutional Provisions covered by the Bill of Rights. Property Rights cannot be taken away without due process of law as otherwise havoc would prevail in contractual relationships.

CONCLUSION

The questions presented are important questions covering Federal Law affecting the interests of every patent owner and manufacturer in the United States. The writ of certiorari should, therefore, be granted.

Respectfully submitted,

CHARLES F. RUBSAM

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General Information Concerning

PATENTS

March 1, 1954

U. S. Department of Commerce
Sinclair Weeks, Secretary

Patent Office
Robert C. Watson, Commissioner

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For sale by the Superintendent of Documents, Washington 25, D. C., or any of the Department's field offices. Price 15 cents.

GENERAL INFORMATION CONCERNING PATENTS

In view of the large amount of mail received by the Patent Office, a copy of this pamphlet, with particular sections marked when appropriate, may be sent in reply to inquiries.

PURPOSE OF THIS BOOKLET

The purpose of this booklet is to give some general information about patents and about the workings of the Patent Office. It answers many questions which are commonly asked of the Patent Office. It is not intended for the patent lawyer, nor is it intended to be a textbook on patent law. Consequently, many details are omitted and complications have been avoided as much as possible. It is hoped that this pamphlet will be useful to inventors and prospective applicants for patent, to students, and to others who may be interested in its subject matter, to give them a brief general introduction to the subject. Additional information may be obtained from the publications Patent Laws and Rules of Practice in Patent Cases, listed on page 6. The Patent Office does not publish any textbooks on patent law, but a number of such works both for the specialist and for the general reader, have been published by private concerns.

WHAT IS A PATENT?

A patent for an invention is a grant by the Government to the inventor (or his heirs or assigns) of certain exclusive rights to his invention for the term of 17 years, throughout the United States.

A patent is granted by the Government acting through the Patent Office.

The subject matter of the patent grant is an invention.

The person entitled to receive the patent grant is the inventor (or his heirs or assigns).

The duration of the patent grant is 17 years.

The right conferred by the patent grant extends throughout the United States and its Territories and possessions.

The right conferred by the patent grant is, in the language of the statute and of the grant itself, "the right to exclude others from making, using, or selling" the invention. What is granted is not the right to make, use, or sell, but the right to exclude others from making, using, or selling the invention.

Most of the statements made in the preceding paragraphs will be explained in greater detail in later sections.

Some persons occasionally confuse patents, copyrights, and trade-marks. Although there may be some resemblance in the rights of these three kinds of intangible property, they are completely different and serve different purposes.

COPYRIGHTS

Copyright protects the writings of an author against copying. Literary, dramatic, musical and artistic works are included within the protection of the copyright law, which in some instances also confers performing and recording rights. The copyright goes to the form of expression rather than to the subject matter of the writing. A description of a machine could be copyrighted as a writing, but this would only prevent others from copying the description—it would not prevent others from writing a description of their own or from making and using the machine. Copyrights are registered in the Copyright Office in the Library of Congress and the Patent Office has nothing whatever to do with copyrights. Information concerning copyrights may be obtained by addressing "Register of Copyrights, Library of Congress, Washington 25, D. C."

TRADE-MARKS

A trade-mark relates to the name or symbol used in trade with goods to indicate the source or origin of the goods. Trade-mark rights will prevent others from using the same name on the same goods, but do not prevent others from making the same goods without using the trade-mark. Trade-marks which are used in interstate or foreign commerce may be registered in the Patent Office. The procedure relating to the registration of trade-marks and some general information concerning trade-marks is given in a pamphlet called General Information Concerning Trade-Marks, which may be obtained from the Patent Office on request.

PATENT LAWS

The Constitution of the United States gives Congress the power to enact laws relating to patents, in Article 1, section 8, which reads "Congress shall have power * * * to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries." Under this power Congress has from time to time enacted various laws relating to patents. The first patent law was enacted in 1790. The law now in effect is a general revision which was enacted on July 19, 1952, and which came into effect on January 1, 1953. This law is reprinted in a pamphlet entitled "Patent Laws," which is sold by the Superintendent of Documents, Government Printing Office, Washington 25, D. C.

The patent law specifies the subject matter for which a patent may be obtained and the conditions for patentability. The law establishes the Patent Office for administering the law relating to the granting of patents, and contains various other provisions relating to patents.

WHAT CAN BE PATENTED?

The patent law specifies the general field of subject matter capable of being patented and the conditions under which a patent may be obtained.

In the language of the statute any person who "invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvements thereof, may obtain a patent," subject to the conditions and requirements of the law. By the word "process" is meant a process or method, and new processes, primarily industrial or technical processes, may be patented. The term "machine" used in the statute needs no explanation. The term "manufacture" refers to articles which are made, and includes all manufactured articles. The term "composition of matter" relates to chemical compositions and may include mixtures of ingredients as well as new chemical compounds. These classes of subject matter taken together include practically everything which is made by man and the processes for making them.

The Atomic Energy Act of 1946 excludes the patenting of inventions useful solely in the production of fissionable material and inventions for utilization of fissionable material or atomic energy for military purposes.

The statute specifies that the subject matter must be "useful." The term "useful" in this connection refers to the condition that the subject matter has a useful purpose and also includes operativeness, that is, a machine which will not operate to perform the intended purpose would not be called useful. Alleged inventions of perpetual motion machines are refused patents.

Interpretations of the statute by the courts have defined the limits of the field of subject matter which can be patented, thus it has been held that methods of doing business and printed matter cannot be patented. In the case of mixtures of ingredients, such as medicines, a patent cannot be granted unless there is more to the mixture than the effect of its components. (So-called patent medicines are not patented; the phrase "patent medicine" in this connection does not have the meaning that the medicine is patented.) It is often said that a patent cannot be obtained upon a mere idea or suggestion. The patent is granted upon the new machine, manufacture, etc., as has been said, and not upon the idea or suggestion of the new machine. As will be stated later, a complete description of the actual machine or other subject matter sought to be patented is required.

NOVELTY AND OTHER CONDITIONS FOR OBTAINING A PATENT

In order for an invention to be patentable it must be new as defined in the statute. The statute provides that an invention cannot be patented if—

"(*a*) The invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

"(*b*) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this

country, more than 1 year prior to the date of the application for patent in the United States, * * *."

If the invention has been described in a printed publication anywhere in the world, or if it has been in public use or on sale in this country, before the date that the applicant made his invention, a patent cannot be obtained. If the invention has been described in a printed publication anywhere, or has been in public use or on sale in this country, more than 1 year before the date on which an application for patent is filed in this country, a patent cannot be obtained. In this connection it is immaterial when the invention was made, or whether the printed publication or public use was by the inventor himself or by someone else. If the inventor describes the invention in a printed publication or uses the invention publicly, or places it on sale, he must apply for a patent before 1 year has gone by, otherwise any right to a patent will be lost.

Even if the subject matter sought to be patented is not exactly shown by the prior art, and involves one or more differences over the most nearly similar thing already known, a patent may still be refused if the differences would be obvious. The subject matter sought to be patented must be sufficiently different from what has been used or described before that it may be said to amount to invention over the prior art. Small advances that would be obvious to a person having ordinary skill in the art are not considered inventions capable of being patented. For example the substitution of one material for another, or changes in size, are ordinarily not patentable.

THE UNITED STATES PATENT OFFICE

Congress has established the United States Patent Office to perform the function of issuing patents on behalf of the Government. The Patent Office as a distinct bureau may be said to date from the year 1802 when a separate official in the Department of State who became known as "Superintendent of Patents" was placed in charge of patents. The revision of the patent laws enacted in 1836 reorganized the Patent Office and designated the official in charge as Commissioner of Patents. The Patent Office remained in the Department of State until 1849 when it was transferred to the Department of the Interior, and in 1925 it was transferred to the Department of Commerce, in which Department it is today.

The chief functions of the Patent Office are to administer the patent laws as they relate to the granting of letters patent for inventions, and to perform other duties relating to patents. It examines applications for patents to ascertain if the applicants are entitled to patents under the law, and grants the patents when they are so entitled; it publishes issued patents and various publications concerning patents and patent laws, records assignments of patents, maintains a search room for the use of the public to examine issued patents and records, supplies copies of records and other papers, and the like. Analogous and similar functions are performed with respect to the registration of trade-marks.

The head of the Office is the Commissioner of Patents and his staff includes several assistant commissioners of patents and other officials.

As head of the office, the Commissioner superintends or performs all duties respecting the granting and issuing of patents and the registration of trade-marks; exercises general supervision over the entire work of the Patent Office; prescribes the rules, subject to the approval of the Secretary of Commerce, for the conduct of proceedings in the Patent Office and for recognition of attorneys and agents; decides various questions brought before him by petition as prescribed by the rules, and performs other duties necessary and required for the administration of the Patent Office and the performance of its functions.

The examination of applications for patent is the largest and most important function of the Patent Office. The work is divided among a number of examining divisions, each division having jurisdiction over certain assigned fields of invention. Each division is headed by a primary (or principal) examiner and staffed by a number of examiners. The examiners perform the work of examining applications for patents and determine whether patents can be granted. An appeal can be taken to the Board of Appeals from their decisions refusing patents and a review by the Commissioner of Patents may be had on other matters by petition. The examiners also determine when an interference exists between pending applications, or a pending application and a patent, institute interference proceedings in such cases and hear and decide certain preliminary questions raised by contestants.

In addition to the examining divisions, the Patent Office has a number of sections, divisions, or branches which perform various other services, such as receiving and distributing mail, receiving new applications, handling sales of printed copies of patents, making manuscript and photostat copies of records, inspecting drawings, recording assignments, and so on.

At the present time the Patent Office has about 1,650 employees, of whom about half are examiners and others with technical and legal training. Patent applications are received at the rate of over 60,000 per year. The Patent Office receives over two and a half million pieces of mail each year.

PUBLICATIONS OF THE PATENT OFFICE

Patents.—The specification and accompanying drawings of all patents are published on the day they are granted, and printed copies are sold to the public by the Patent Office. Over 2,600,000 patents have been issued.

Printed copies of any patent identified by its patent number, may be purchased from the Patent Office at a cost of 25 cents each, postage free, except design patents which are 10 cents each.

The Patent Office maintains two sets of patents, one set in numerical order and one set arranged by subject matter, for the use of the public. Single sets of patents are maintained in the following libraries: Albany, N. Y., University of State of New York; Atlanta, Ga., Georgia Tech Library; Boston, Mass., Public Library; Buffalo, N. Y., Grosvenor Library; Chicago, Ill., Public Library; Cincinnati, Ohio, Public Library; Cleveland, Ohio, Public Library; Columbus, Ohio, Ohio State University Library; Detroit, Mich., Public Library; Kansas City, Mo., Linda Hall Library; Los Angeles, Calif., Public Library; Madison, Wis., State Historical Society of Wisconsin; Milwaukee,

Wis., Public Library; Minneapolis, Minn., Public Library; Newark, N. J., Public Library; New York, N. Y., Public Library; Philadelphia, Pa., Franklin Institute; Pittsburgh, Pa., Carnegie Library; Providence, R. I., Public Library; St. Louis, Mo., Public Library; Toledo, Ohio, Public Library.

Official Gazette of the United States Patent Office.—The Official Gazette of the United States Patent Office is the official journal relating to patents and trade-marks. It has been published weekly since January 1872 (replacing the old Patent Office Reports), and is now issued each Tuesday, simultaneously with the weekly issue of the patents. It contains a claim and a selected figure of the drawings of each patent granted on that day; decisions in patent and trade-mark cases rendered by the courts and the Patent Office; notices of patent and trade-mark suits; indexes of patents and patentees; lists of patents available for license or sale; and much general information such as orders, notices, changes in rules, changes in classification, etc.

The Official Gazette is sold, by annual subscription and in single copies, by the Superintendent of Documents, Washington, D. C.

Beginning with July 1952, the illustrations and claims of the patents are arranged in order according to the Patent Office classification of subject matter. New patents relating to any particular field can thus be located more readily. Copies of the Official Gazette may be found in public libraries of larger cities.

Annual index.—The annual index to the Official Gazette contains alphabetical indexes of the names of patentees and of the subject matter of the patents granted, during the calendar year. Copies are sold by the Superintendent of Documents. At present it is issued in two volumes, one for patents and one for trade-marks.

Decisions of the Commissioner of Patents.—There is issued annually a volume republishing the decisions which have been published weekly in the Official Gazette. Copies are sold by the Superintendent of Documents.

Manual of Classification.—The present manual of classification is a large loose-leaf book containing a list of all the classes and subclasses of inventions in the Patent Office classification of patents, a subject matter index, and other information relating to classification. Substitute pages are issued from time to time. The manual and subscriptions for the substitute pages are sold by the Superintendent of Documents.

Classification Bulletins.—The various changes and advances in classification made from time to time are collected and published in bulletins which give these changes as well as the definitions of new and revised classes and subclasses. These bulletins are sold by the Superintent of Documents, as well as by the Patent Office.

Patent Laws.—A compilation of the patent laws in force is issued and revised editions are published from time to time. Copies may be purchased from the Superintendent of Documents for 25 cents.

Rules of Practice of the United States Patent Office.—This publication contains the rules governing the procedure in the Patent Office which have been adopted by the Commissioner under the authority of the patent statutes and approved by the Secretary of Commerce, and supplementary material including forms and relevant sections of the patent law. Copies may be purchased from the Superintendent of Documents for 50 cents.

Rules of Practice in Trade-Mark Cases With Forms and Statutes.—This publication combines in pamphlet form the Rules of Practice in Trade-Mark cases and the Federal trade-mark statute. Copies may be purchased from the Superintendent of Documents for 50 cents.

General Information Concerning Patents.—This pamphlet is designed for the layman and contains a large amount of general information concerning the granting of patents expressed in nontechnical language. Single copies are distributed by the Commissioner free on request.

General Information Concerning Trade-Marks.—This pamphlet serves the same purpose with reference to trade-marks as the preceding does concerning patents.

Roster of Attorneys and Agents Registered to Practice before the United States Patent Office.—This list of registered attorneys and agents, arranged alphabetically and by States and cities is sold by the Superintendent of Documents for $1.00.

Manual of Patent Examining Procedure.—This manual is written for examiners in the Patent Office and gives in great detail the procedures followed by the examiners. It is available to the public and is sold by the Superintendent of Documents.

Guide for Patent Draftsmen.—A statement of Office requirements for patent drawings with illustrations. Sold by the Superintendent of Documents for 15 cents.

GENERAL INFORMATION AND CORRESPONDENCE

All business with the Patent Office should be transacted in writing and all letters addressed to the Commissioner of Patents, Washington 25, D. C. The personal attendance of applicants at the Patent Office is unnecessary.

Applicants and attorneys will be required to conduct their business with the Office with decorum and courtesy. Papers presented in violation of this requirement will be returned.

A separate letter (but not necessarily a separate envelope) should be written in relation to each distinct subject of inquiry such as assignments for recording, payment of final fees, orders for printed copies of patents, orders for photostatic copies of records, and requests for other services. None of these should be included with letters responding to Office actions in applications (p. 16).

When a letter concerns a patent, it should state the name of the patentee, the invention, and the patent number and date.

In making inquiry concerning the status of an application, the inventor should be sure to give its serial number and filing date.

An order for a copy of assignment must give the liber and page of the record, as well as the name of the inventor; otherwise an extra charge will be made for the time consumed in making any search for such assignment.

Applications for patent are not open to the public and no information concerning them is given except on authority of the applicant, his assignee, or his attorney, or when necessary to the conduct of the business of the Office. Patents and the records relating to the same including any decisions therein, the records of assignments, books, and

other records and papers in the Office, are open to the public and may be inspected in the Patent Office or copies may be ordered.

The Office cannot respond to inquiries concerning the novelty and patentability of an invention in advance of the filing of an application, nor give advice as to possible infringement of a patent, nor advise of the propriety of filing an application, nor respond to inquiries as to whether any alleged invention has been patented, and if so, to whom, nor can the Office act as an expounder of the patent law nor as counselor for individuals, except in deciding questions arising before it in regularly filed cases. Information of a general nature may be furnished either directly or by supplying or calling attention to an appropriate publication.

LIBRARY, SEARCH ROOM, SEARCHES

The Scientific Library of the Patent Office contains over 35,000 volumes of scientific and technical books in various languages, about 40,000 bound volumes of periodicals devoted to science and technology, the official journals of foreign patent offices, and over 6,000,000 copies of foreign patents in bound volumes. In many cases there are two sets of foreign patents, one set arranged in numerical order and one set classified according to the classification of the country of origin of the patent.

A search room is maintained for the benefit of the public in searching and examining United States patents. It contains a set of United States patents granted since 1836 arranged according to the Patent Office classification. By searching in these classified patents, it is possible to determine, before actually filing an application, whether an invention has been anticipated by a United States patent, and it is possible to obtain the information contained in the patents relating to any field of endeavor. In the Patent Office classification patents are classified into 309 classes and 47,000 subclasses.

Adjoining the search room is a record room in which the public may inspect the records and files of issued patents and such other records as may be open to their inspection. The record room contains a set of United States patents arranged in numerical order, in bound volumes, and a complete set of the Official Gazette.

Applicants and their attorneys or agents may examine their own cases in the record room and public records may be examined in the record room, search room, or library, as the case may be. Applicants, their attorneys or agents, and the general public are not entitled to use the records and files in the examiner's rooms.

The search room and scientific library are open during office hours from 8:30 a. m. to 5 p. m. on workdays, and, in addition, the search room is open evenings from 5 p. m. to 9 p. m. on workdays, and on Saturdays from 8:30 a. m. to 12:30 p. m.

Since a patent is not always granted when an application is filed, many inventors attempt to make their own investigation before applying for a patent. This may be done in the search room of the Patent Office, and to a limited extent in some public libraries or through whatever sources of published knowledge that may be available. Patent attorneys or agents may be employed to make a so-called preliminary search through the prior United States patents to discover if the particular device has been shown in some prior patent. This search is not always as complete as that made by the Patent Office dur-

ing the examination of an application, but only serves, as its name indicates, a preliminary purpose.

ATTORNEYS AND AGENTS

The preparation of an application for patent and the conducting of the proceedings in the Patent Office to obtain the patent is an undertaking requiring knowledge of patent law and Patent Office practice as well as knowledge of the scientific or technical matters involved in the particular invention.

The inventor may prepare his own application and file it in the Patent Office and conduct the proceedings himself, but unless he is familiar with these matters or studies them in detail, he may get into considerable difficulties. While a patent may be obtained in many cases by persons not skilled in this work, there would be no assurance that the patent obtained would adequately protect the particular invention.

Most inventors employ the services of persons known as patent attorneys or patent agents to do the work for them. The statute gives the Patent Office the power to make rules and regulations governing the recognition of patent attorneys and agents to practice before the Patent Office, and persons who are not recognized by the Patent Office for this practice are not permitted by law to represent inventors. The Patent Office maintains a register of attorneys and agents. To be admitted to this register, a person must comply with the regulations prescribed by the Office, which now require a showing of the necessary qualifications and the passing of an examination. The Patent Office registers both attorneys at law and persons who are not attorneys at law. The former persons are now referred to as "patent attorneys" and the latter persons are referred to as "patent agents." Insofar as the work of preparing an application for patent and conducting the prosecution in the Patent Office is concerned, patent agents are usually just as well-qualified as patent attorneys, although patent agents cannot conduct patent litigation in the courts or perform various services which the local jurisdiction considers as practicing law, for example, a patent agent could not draw up a contract relating to a patent, such as an assignment or a license, if the State in which he resides considers drawing contracts as practicing law.

Some patent attorneys and agents advertise their services in magazines, particularly popular magazines of a mechanical or technical nature, and in telephone books. Only about two percent of the persons registered in the Patent Office advertise their services in this manner. The reason for this is that most patent attorneys and agents consider it unprofessional to advertise. Many of them belong to professional organizations having standards of conduct which prohibit such advertising.

The Patent Office cannot recommend any particular attorney or agent, or aid in the selection of an attorney or agent. It publishes a list of all the persons registered, arranged alphabetically and by States and cities. The telephone directories of most large cities have, in the classified section, a heading for patent attorneys under which those in that area are listed. Many large cities have associations of patent attorneys.

In employing a patent attorney or agent, the inventor executes a power of attorney or authorization of agent which must be filed in the Patent Office and is usually a part of the application papers. When an attorney has been appointed, the Office does not communicate with the inventor directly but conducts the correspondence with the attorney since he is acting for the inventor thereafter, although the inventor is free to ask the Patent Office concerning the status of his application. The Patent Office sends two copies of letters to the attorney or agent so that the extra copy may be sent by the attorney or agent to the inventor for his information. The inventor may remove the attorney or agent by revoking the power or authorization.

The Patent Office has the power to disbar, or suspend from practicing before it, persons guilty of gross misconduct, etc., but this can only be done after a full hearing with the presentation of evidence concerning the misconduct. The Patent Office will receive and in appropriate cases act upon complaints against attorneys and agents.

WHO MAY APPLY FOR A PATENT

According to the statute only the inventor may apply for a patent, with certain exceptions. If a person who is not the inventor applies for a patent, the patent, if it were obtained, would be void. The person applying in such a case would be committing perjury and may also be subject to criminal penalties for committing perjury. If the inventor is dead, the application may be made by his legal representatives, that is, the administrator or executor of his estate, in his place. If the inventor is insane, the application for patent may be made by his guardian, in his place.

If two or more persons make an invention jointly, they apply for a patent as joint inventors. A person who makes a financial contribution is not a joint inventor and cannot be joined in the application as an inventor. It is possible to correct an innocent mistake in omitting a joint inventor or in erroneously joining a person as inventor.

APPLICATION FOR PATENT

The application for patent is made to the Commissioner of Patents and includes:

(1) A written document which comprises a petition, a specification (description and claims), and an oath;

(2) A drawing in those cases in which a drawing is possible; and

(3) The Government filing fee of $30 (plus an additional $1 for each claim in excess of 20).

The petition, specification, and oath must be in the English language and must be legibly written in permanent ink on one side of the paper. The Office prefers typewriting on legal size paper, 8 to 8½ by 12½ to 13 inches, with margins of 1½ inches on the left-hand side and at the top. If the papers filed are not correctly, legibly, and clearly written, the Patent Office may require typewritten or printed papers.

The application for patent is not accepted and placed upon the files for examination until all its required parts, complying with the rules relating thereto, are received, except that certain minor informalities are waived subject to correction when required.

If the papers and parts are incomplete, or so defective that they cannot be accepted as a complete application for examination, the applicant will be notified; the papers will be held for a time for completion and, if not completed, will be stored as an abandoned incomplete application and eventually destroyed or otherwise disposed of. The filing fee may be refunded when an application is refused acceptance as incomplete.

It is desirable that all parts of the complete application be deposited in the Office together; otherwise each part must be signed and a letter must accompany each part, accurately and clearly connecting it with the other parts of the application.

Complete applications are numbered in regular order, and the applicant is informed of the serial number and filing date of the application by a filing receipt. The filing date of the application is the date on which a complete application, acceptable for placing in the files for examination, is received in the Patent Office; or the date on which the last part completing such application is received in the case of an incomplete or defective application which is completed and accepted.

PETITION, OATH, SIGNATURE

The petition amounts to the request for a patent and may follow various forms which are given in the list of forms printed at the end of this pamphlet. Ordinarily the power of attorney or authorization of agent is included in the petition, but this may be a separate paper.

The oath of the applicant is required by statute. The inventor must make an oath that he believes himself to be the original and first inventor of the subject matter of the application, and he must make various other allegations required by the statute and various allegations required by the Patent Office rules. The form of oath in the usual case is given in the list of forms. The oath must be sworn to by the inventor before a notary public or other officer authorized to administer oaths.

The application must be signed by the inventor in person. The full name is required, including the full first name without abbreviation and the middle initial or name, if any. The post-office address of the inventor himself is also required. It is ordinarily included in the petition.

Blank forms for applications or other papers are not supplied by the Patent Office. Some specimen forms are given at the end of this pamphlet.

The papers in a complete application will not be returned for any purpose whatever, nor will the filing fee be returned. If applicants have not preserved copies of the papers, the Office will furnish copies at the usual cost.

SPECIFICATION (DESCRIPTION AND CLAIMS)

The specification must include a written description of the invention and of the manner and process of making and using it, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art to which the invention pertains, or with which it is most nearly connected, to make and use the same.

The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvements invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

A brief summary of the invention indicating its nature and substance, which may include a statement of the object of the invention, should precede the detailed description. Such summary should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed.

When there are drawings, there shall be a brief description of the several views of the drawings, and the detailed description of the invention shall refer to the different views by specifying the numbers of the figures, and to the different parts by use of reference letters or numerals (preferably the latter).

The specification must conclude with one or more claims particularly pointing out and distinctly claiming the subect matter which the applicant regards as his invention.

When more than one claim is presented, they may be placed in dependent form in which a claim may refer back to and further restrict a single preceding claim.

The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.

The claims are brief descriptions of the subject matter of the invention, eliminating unnecessary details and reciting all essential features necessary to distinguish the invention from what is old. The claims are the operative part of the patent. Novelty and patentability are judged by the claims, and, when a patent is granted, questions of infringement are judged by the courts on the basis of the claims.

The following order of arrangement should be observed in framing the specification:

(*a*) Title of the invention; or a preamble stating the name, citizenship, and residence of the applicant and the title of the invention may be used.

(*b*) Brief summary of the invention.

(*c*) Brief description of the several views of the drawing, if there are drawings.

(*d*) Detailed description.

(*e*) Claim or claims.

DRAWING

A drawing is required by the statute in all cases which admit of drawings. This includes practically all inventions except composi-

tions of matter or processes, but a drawing may also be useful in the case of many processes.

The drawing may be signed by the inventor himself or it may be signed by the attorney or agent for the inventor (but note that the signature to the written part of the application must be that of the inventor himself and cannot be signed by anyone else).

The drawing must show every feature of the invention specified in the claims and is required by the Office rules to be in a particular form. The Office specifies the size of the sheet on which the drawing is made, the type of paper, the margins, and other details relating to the making of the drawing. The reason for specifying the standards in detail is that the drawings are printed and published in a uniform style when the patent issues, and the drawings must also be such that they can be readily understood by persons using the patent descriptions.

The following is the rule relating to the standards for drawings:

84. *Standards for drawings.*—The complete drawing is printed and published when the patent issues, and a copy is attached to the patent. This work is done by the photolithographic process, the sheets of drawings being reduced about one-third in size. In addition, a reduction of a selected portion of the drawings of each application is published in the Official Gazette. It is therefore necessary for these and other reasons that the character of each drawing be brought as nearly as possible to a uniform standard of execution and excellence, suited to the requirements of the reproduction process and of the use of the drawings, to give the best results in the interests of inventors, of the Office, and of the public. The following regulations with respect to drawings are accordingly prescribed:

(*a*) *Paper and ink.*—Drawings must be made upon pure white paper of a thickness corresponding to two-ply or three-ply Bristol board. The surface of the paper must be calendared and smooth and of a quality which will permit erasure and correction. India ink alone must be used for pen drawings to secure perfectly black solid lines. The use of white pigment to cover lines is not acceptable.

(*b*) *Size of sheet and margins.*—The size of a sheet on which a drawing is made must be exactly 10 by 15 inches. One inch from its edges a single marginal line is to be drawn, leaving the "sight" precisely 8 by 13 inches. Within this margin all work must be included. One of the shorter sides of the sheet is regarded as its top, and, measuring down from the marginal line, a space of not less than 1¼ inches is to be left blank for the heading of title, name, number, and date, which will be applied subsequently by the Office in a uniform style.

(*c*) *Character of lines.*—All drawings must be made with drafting instruments or by photolithographic process which will give them satisfactory reproduction characteristics. Every line and letter (signatures included) must be absolutely black. This direction applies to all lines however fine, to shading, and to lines representing cut surfaces in sectional views. All lines must be clean, sharp, and solid, and fine or crowded lines should be avoided. Solid black should not be used for sectional or surface shading. Free-hand work should be avoided wherever it is possible to do so.

(*d*) *Hatching and shading.*—Hatching should be made by oblique parallel lines, which may be not less than about one-twentieth inch apart.

Heavy lines on the shade side of objects should be used except where they tend to thicken the work and obscure reference characters. The light should come from the upper left-hand corner at an angle of 45°. Surface delineations should be shown by proper shading, which should be open.

(*e*) *Scale.*—The scale to which a drawing is made ought to be large enough to show the mechanism without crowding when the drawing is reduced in reproduction, and views of portions of the mechanism on a larger scale should be used when necessary to show details clearly; two or more sheets should be used if one does not give sufficient room to accomplish this end, but the number of sheets should not be more than is necessary.

(*f*) *Reference characters.*—The different views should be consecutively numbered figures. Reference numerals (and letters, but numerals are preferred) must be plain, legible, and carefully formed, and not be encircled. They should if possible, measure at least one-eight of an inch in height so that they may bear reduction to one twenty-fourth of an inch; and they may be slightly larger when

there is sufficient room. They must not be so placed in the close and complex parts of the drawing as to interfere with a thorough comprehension of the same, and therefore should rarely cross or mingle with the lines. When necessarily grouped around a certain part, they should be placed at a little distance, at the closest point where there is available space, and connected by lines with the parts to which they refer. They should not be placed upon hatched or shaded surfaces but when necessary, a blank space may be left in the hatching or shading where the character occurs so that it shall appear perfectly distinct and separate from the work. The same part of an invention appearing in more than one view of the drawing must always be designated by the same character, and the same character must never be used to designate different parts.

(*g*) *Symbols, legends.*—Graphical drawing symbols for conventional elements may be used when appropriate, subject to approval by the Office. The elements for which such symbols are used must be adequately identified in the specification. While descriptive matter on drawings is not permitted, suitable legends may be used, or may be required in proper cases, as in diagrammatic views and flow sheets. The lettering should be as large as, or larger than, the reference characters.

(*h*) *Location of signature and names.*—The signature of the applicant, or the name of the applicant and signature of the attorney or agent, may be placed in the lower right-hand corner of each sheet within the marginal line, or may be placed below the lower marginal line.

(*i*) *Views.*—The drawing must contain as many figures as may be necessary to show the invention; the figures should be consecutively numbered if possible, in the order in which they appear. The figures may be plain, elevation, section, or perspective views, and detail views of portions or elements, on a larger scale if necessary may also be used. Exploded views, with the separated parts of the same figure embraced by a bracket, to show the relationship or order of assembly of various parts are permissible. When necessary a view of a large machine or device in its entirety may be broken and extended over several sheets if there is no loss in facility of understanding the view (the different parts should be identified by the same figure number but followed by the letters a, b, c, etc., for each part). The plane upon which a sectional view is taken should be indicated on the general view by a broken line, the ends of which should be designated by numerals corresponding to the figure number of the sectional view and have arrows applied to indicate the direction in which the view is taken. A moved position may be shown by a broken line superimposed upon a suitable figure if this can be done without crowding, otherwise a separate figure must be used for this purpose. Modified forms of construction can only be shown in separate figures. Views should not be connected by projection lines nor should center lines be used.

(*j*) *Arrangement of views.*—All views on the same sheet must stand in the same direction and should, if possible, stand so that they can be read with the sheet held in an upright position. If views longer than the width of the sheet are necessary for the clearest illustration of the invention, the sheet may be turned on its side. The space for a heading must then be reserved at the right and the signatures placed at the left, occupying the same space and position on the sheet as in the upright views and being horizontal when the sheet is held in an upright position. One figure must not be placed upon another or within the outline of another.

(*k*) *Figure for Official Gazette.*—The drawing should, as far as possible, be so planned that one of the views will be suitable for publication in the Official Gazette as the illustration of the invention.

(*l*) *Extraneous matter.*—An agent's or attorney's stamp, or address, or other extraneous matter, will not be permitted upon the face of a drawing, within or without the marginal line, except that the title of the invention and identifying indicia, to distinguish from other drawings filed at the same time, may be placed below the lower margin.

(*m*) *Transmission of drawings.*—Drawings, transmitted to the Office should be sent flat, protected by a sheet of heavy binder's board, or may be rolled for transmission in a suitable mailing tube; but must never be folded. If received creased or mutilated, new drawings will be required.

The requirements relating to drawings are strictly enforced, but a drawing not complying with all of the regulations is accepted for purpose of examination, and correction or a new drawing will be required later.

Applicants are advised to employ competent draftsmen to make their drawings. The Office may furnish drawings at applicant's expense as promptly as its draftsmen can make them, for applicants who cannot otherwise conveniently procure them, but to avoid delay the drawings should be made outside the Office.

MODELS, EXHIBITS, SPECIMENS

Models were once required in all cases admitting of a model, as a part of the application, and these models became a part of the record of the patent. Such models are no longer generally required since the description of the invention in the specification, and the drawings, must be sufficiently full and complete, and capable of being understood, to disclose the invention without the aid of a model. A model will not be admitted unless specifically called for.

A model, working model, or other physical exhibit, may be required by the Office if deemed necessary for any purpose on examination of the application. This is not done very often. A working model will be called for in the case of applications for patent for alleged perpetual motion devices.

When the invention relates to a composition of matter, the applicant may be required to furnish specimens of the composition, or of its ingredients or intermediates, for inspection or experiment.

EXAMINATION OF APPLICATIONS AND PROCEEDINGS IN THE PATENT OFFICE

Applications filed in the Patent Office and accepted as complete applications are assigned for examination to the respective examining divisions having charge of the classes of inventions to which the applications relate. In the examining division applications are taken up for examination by the examiner to whom they have been assigned in the order in which they have been filed.

Applications will not be advanced out of turn for examination or for further action except as provided by the rules, or upon order of the Commissioner to expedite the business of the Office, or upon a verified showing which, in the opinion of the Commissioner, will justify so advancing it.

The examination of the application consists in a study of the application for compliance with the legal requirements and a search through the prior art, represented by prior United States patents, prior foreign patents which are available in the United States Patent Office, and such prior literature as may be available, to see if the invention is new. A decision is reached by the examiner in the light of the study and the result of the search as to compliance with the statutes and rules and as to the novelty of the invention as claimed, as well as to formal matters. The examination is ordinarily complete with respect both to compliance of the application with the statute and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.

OFFICE ACTION

The applicant is notified in writing of the examiner's decision by an "action" which is mailed to the attorney or agent. The reasons

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for any adverse action or any objection or requirement are stated in the action and such information or references are given as may be useful in aiding the applicant to judge of the propriety of continuing the prosecution of his application.

The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.

If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable, will be rejected. If the examiner finds that the invention as defined by the claims is not new, the claims are refused. The claims may also be refused if they differ somewhat from what is found to be old but the difference is not considered sufficient to justify a patent.

Terms such as "anticipation," "fully met," "lack of novelty," etc., are used if the invention as claimed is not new, while terms such as "unpatentable over _____," "lacking invention over _____," etc., may be used if the differences over what is old are not considered sufficient to justify a patent.

In rejecting claims for want of novelty or for want of invention, the examiner cites the best references at his command. The pertinence of each reference, if not obvious, is explained and each rejected claim specified.

APPLICANT'S RESPONSE

After the Office action, if adverse in any respect, the applicant, if he persists in his application for a patent, must reply thereto within the time allowed, and may request reexamination or reconsideration, with or without amendment.

In order to be entitled to reexamination or reconsideration, the applicant must make request therefor in writing, and he must distinctly and specifically point out the supposed errors in the examiner's action; the applicant must respond to every ground of objection and rejection in the prior Office action (except that request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until a claim is allowed), and the applicant's action must appear throughout to be a bona fide attempt to advance the case to final action. The mere allegation that the examiner has erred will not be received as a proper reason for such reexamination or reconsideration.

In amending an application in response to a rejection, the applicant must clearly point out the patentable novelty which he thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He must also show how the amendments avoid such references or objections.

After response by applicant the application will be reexamined and reconsidered, and the applicant will be notified if claims are rejected, or objections or requirements made, in the same manner as after the first examination. The applicant may respond to such Office action, in the same manner, with or without further amendment, and the application will be again considered, and so on repeatedly, unless the examiner has indicated that the action is final.

FINAL REJECTION

On the second or any subsequent examination or consideration, the rejection or other action may be made final, whereupon applicant's response is limited to appeal in the case of rejection of any claim and further amendment is restricted. Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim. Response to a final rejection or action must include cancellation of, or appeal from the rejection of, each claim so rejected and, if any claim stands allowed, compliance with any requirement or objection as to form.

In making such final rejection, the examiner repeats or states all grounds of rejection then considered applicable to the claims in the case.

Interviews with examiners may be arranged but an interview does not remove the necessity for response to Office actions within the required time, and the action of the Office is based solely on the written record.

If two or more inventions are claimed in a single application, and are regarded by the Patent Office to be of such a nature that a single patent may not be issued for both of them, the applicant will be required to limit the application to but one of the inventions. The other invention may be made the subject of a separate application which, if filed while the first application is still pending, will be entitled to the benefit of the filing date of the first application. A requirement to restrict the application to one invention may be made before further action by the examiner.

As a result of the examination by the Patent Office, patents are granted in the case of about four out of every seven applications for patents which are filed.

AMENDMENTS TO APPLICATION

The preceding section referred to amendments to the application. Following are some details concerning amendments:

The applicant may amend before or after the first examination and action, and also after the second or subsequent examination or reconsideration as specified in the rules, or when and as specifically required by the examiner.

After final rejection or action amendments may be made canceling claims or complying with any requirement of form which has been made, and amendments presenting rejected claims in better form for consideration on appeal may be admitted; but the admission of any such amendment or its refusal, and any proceedings relative thereto, shall not operate to relieve the application from its condition as subject to appeal or to save it from abandonment.

If amendments touching the merits of the application be presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon a showing of good and sufficient reasons why they are necessary and were not earlier presented.

No amendment can be made as a matter of right in appealed cases. After decision on appeal, amendments can only be made as provided in the rules.

The specification, claims, and drawing must be amended and revised when required, to correct inaccuracies of description and definition or unnecessary prolixity, and to secure correspondence between the claims, the description, and the drawing.

All amendments of the drawings or specifications, and all additions thereto, must conform to at least one of them as it was at the time of the filing of the application. Matter not found in either, involving a departure from or an addi-

tion to the original disclosure, cannot be added to the application even though supported by a supplemental oath, and can be shown or claimed only in a separate application.

The claims may be amended by canceling particular claims, by presenting new claims, or by amending the language of particular claims (such amended claims being in effect new claims). In presenting new or amended claims, the applicant must point out how they avoid any reference or ground of rejection of record which may be pertinent.

Erasures, additions, insertions, or alterations of the papers and records must not be made by the applicant. Amendments are made by filing a paper, directing or requesting that specified changes or additions be made. The exact word or words to be stricken out or inserted in the application must be specified and the precise point indicated where the deletion or insertion is to be made.

Amendments are "entered" by the Office by making the proposed deletions by drawing a line in red ink through the word or words canceled and by making the proposed substitutions or insertions in red ink, small insertions being written in at the designated place and larger insertions being indicated by reference.

No change in the drawing may be made except by permission of the Office. Permissible changes in the construction shown in any drawing may be made only by the Office. A sketch in permanent ink showing proposed changes, to become part of the record, must be filed. The paper requesting amendments to the drawing should be separate from other papers. The drawing may not be withdrawn from the Office except for signature.

Substitute drawings will not ordinarily be admitted in any case unless required by the Office.

If the number or nature of the amendments render it difficult to consider the case, or to arrange the papers for printing or copying, the examiner may require the entire specification or claims, or any part thereof, to be rewritten. A substitute specification will ordinarily not be accepted unless it has been required by the examiner.

The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When claims are added by amendment or substituted for canceled claims, they must be numbered by the applicant consecutively beginning with the number next following the highest numbered claim previously presented. When the application is ready for allowance, the examiner, if necessary, will renumber the claims consecutively in the order in which they appear or in such order as may have been requested by applicant.

TIME FOR RESPONSE AND ABANDONMENT

The response of an applicant to an action by the Office must be made within a prescribed time limit. This time limit is set at 6 months by the statute. If no response is received within the 6 months, the application is considered as abandoned and no longer pending. However, if it can be shown that the failure to prosecute was unavoidable, the application may be revived by the Commissioner. This revival requires a petition to the Commissioner, accompanied by a verified showing of the cause of the delay and a fee for the petition, which should be filed without delay. The proper response must also accompany the petition if it has not yet been filed.

The statute also provides that the Commissioner may shorten the time for reply to not less than 30 days. This is done by the Office only for particular reasons and in particular classes of cases and, if no reply is received within the shortened time period, the application is similarly considered as abandoned.

APPEAL TO THE BOARD OF APPEALS AND TO THE COURT

If the examiner persists in his rejection of any of the claims in an application, or if the rejection has been made final, the applicant may appeal to the Board of Appeals in the Patent Office. The Board of Appeals consists of the Commissioner of Patents, the Assistant Commissioners, and nine examiners-in-chief, but normally each appeal is heard by only three members. An appeal fee is required and the applicant must file a brief to support his position. He is entitled to an oral hearing if he desires one.

If the decision of the Board of Appeals is still adverse to the applicant, he has a choice of appealing to the Court of Customs and Patent Appeals or of filing a civil action against the Commissioner of Patents in the United States District Court for the District of Columbia. The court in the appeal will review the record made in the Patent Office and may affirm or reverse the action taken by the Patent Office. In the civil action, the applicant may present testimony in the court, and the court will make a decision holding that he either is or is not entitled to the patent as may be determined.

INTERFERENCES

Occasionally two or more applications are filed by different inventors claiming substantially the same patentable invention. The patent can only be granted to one of them, and a proceeding known as an "interference" is instituted by the Patent Office to determine who is the first inventor and entitled to the patent. About 1 percent of the applications filed become involved in an interference proceeding. Interference proceedings may also be instituted between an application and a patent already issued, provided the patent has not been issued for more than 1 year prior to the filing of the conflicting application, and provided that the conflicting application is not barred from being patentable for some other reason.

Each party to such a proceeding must submit evidence of facts proving when he made the invention. In view of the necessity of proving the various facts and circumstances concerning the making of the invention during an interference, inventors must be able to produce evidence to do this. If no evidence is submitted a party is restricted to the date of filing his application as his earliest date. The priority question is determined by a board of three interference examiners on the evidence submitted. From the decision of the Board of Patent Interferences, the losing party may appeal to the Court of Customs and Patent Appeals or file a civil action against the winning party in the appropriate United States district court.

The terms "conception of the invention" and "reduction to practice" are encountered in connection with priority questions. Conception of the invention refers to the completion of the devising of the means for accomplishing the result. Reduction to practice refers to the actual construction of the invention in physical form; in the case of a machine it includes the actual building of the machine, in the case of an article or composition it includes the actual making of the article or composition, in the case of a process it includes the actual carrying out of the steps of the process; and actual operation,

demonstration, or testing for the intended use is also usually necessary. The filing of a regular application for patent completely disclosing the invention is treated as equivalent to reduction to practice. The inventor who proves to be the first to conceive the invention and the first to reduce it to practice will be held to be the prior inventor, but more complicated situations cannot be stated this simply.

ALLOWANCE AND ISSUE OF PATENT

If on the examination of the application, or at a later stage during the reexamination or reconsideration of the application, the patent application is found to be allowable, the applicant is sent a notice of allowance, and a fee for issuing the patent is due within 6 months from the date of the notice. This fee is $30, and $1 for each claim in excess of 20. If the final fee is not paid, the application becomes "forfeited" and is abandoned, but a provision is made in the statute whereby the Commissioner may accept the fee late, up to 1 year, on a showing of unavoidable delay. When the final fee is paid, the patent ordinarily issues on the fifth Tuesday after the date of the payment, and the patent grant is delivered or mailed on the day of its grant to the inventor or to the attorney or agent, if there is one.

On the date of the grant, printed copies of the specification and drawing are available for sale and the record of the patent in the Patent Office becomes open to the public.

In case the publication of an invention by the granting of a patent would be detrimental to the national defense, the patent law gives the Commissioner of Patents the power to withhold the grant of the patent and to order the invention kept secret for such period of time as the national interest requires.

NATURE OF PATENT AND PATENT RIGHTS

The patent is issued in the name of the United States under the seal of the Patent Office, and is either signed by the Commissioner of Patents or has his name written thereon and attested by an official of the Patent Office. The patent contains a grant to the patentee and a printed copy of the specification and drawing is annexed to the patent and forms a part of it. The grant to the patentee is of "the right to exclude others from making, using or selling the invention throughout the United States" for the term of 17 years. The United States in this phrase includes Territories and possessions. Formerly the grant read "the exclusive right to make, use, and vend" the invention; this meant the same thing as the present wording.

The exact nature of the right conferred must be carefully distinguished, and the key is in the words "right to exclude" in the phrase just quoted. The patent does not grant the right to make, use, or sell the invention but only grants the exclusive nature of the right. Any person is ordinarily free to make, use, or sell anything he pleases, and a grant from the Government is not necessary. The patent only grants the right to exclude others from making, using, or selling the invention. Since the patent does not grant the right to make, use, or sell the invention, the patentee's own right to do so is dependent upon the rights of others and whatever general laws might be applicable. A patentee, merely because he has received a patent for an invention, is

not thereby authorized to make, use, or sell the invention if doing so would violate any law. An inventor of a new automobile would not be entitled to use his new automobile in violation of the laws of a State requiring a license, because he has obtained a patent, nor may a patentee sell an article the sale of which may be forbidden by a law, merely because he has obtained a patent. Neither may a patentee make, use or sell his own invention if doing so would infringe the prior rights of others. A patentee may not violate the Federal antitrust laws, such as by resale price agreements or entering into combinations in restraint of trade, or the pure food and drug laws, by virtue of his having a patent. Ordinarily there is nothing which prohibits a patentee from making, using, or selling his own invention.

Since the essence of the right granted by a patent is the right to exclude others from commercial exploitation of the invention, the patentee is the only one who may make, use, or sell his invention. Others may not do so without authorization from the patentee. The patentee may manufacture and sell the invention himself or he may license, that is, give authorization to others to do so.

The term of a patent is 17 years. After the patent has expired, anyone may make, use, or sell the invention without permission of the patentee. The term may not be extended except by special act of Congress. Provision was made by a law which has now expired for granting extensions of patents owned by veterans of World War II.

CORRECTION OF PATENTS

Once the patent is granted, it is outside of the jurisdiction of the Patent Office except in a few respects.

The Patent Office may issue without charge a certificate correcting a clerical error it has made in the patent when the patent does not correspond to the record in the Patent Office. These are mostly corrections of typographical errors made in printing.

Some minor errors of a typographical nature made by the applicant may be corrected by a certificate of correction for which a charge is made.

The patentee may disclaim one or more claims of his patent by filing in the Patent Office a disclaimer as provided by the statute.

When the patent is defective in various respects, the law provides that the patentee may apply for a reissue patent. This is a patent granted to replace the first one and is granted only for the balance of the unexpired term. However, the nature of the changes that can be made by means of the reissue are rather limited; new matter cannot be added.

ASSIGNMENTS AND LICENSES

A patent is personal property and may be sold to others or mortgaged; it may be bequeathed by a will, and it may pass to the heirs of a deceased patentee. The patent law provides for the transfer or sale of a patent, or of an application for patent, by an instrument in writing. Such an instrument is referred to as an assignment and may transfer the entire interest in the patent. The assignee, when the patent is assigned to him, becomes the owner of the patent and he has the same rights that the original patentee had.

The statute also provides for the assignment of a part interest, that is, a half interest, a fourth interest, etc., in a patent. There may also be a grant which conveys the same character of interest as an assignment but only for a particular specified part of the United States.

A mortgage of patent property passes ownership thereof to the mortgagee or lender until the mortgage has been satisfied and a retransfer from the mortgagee back to the mortgagor, the borrower, is made. A conditional assignment also passes ownership of the patent and is regarded as absolute until canceled by the parties or by the decree of a competent court.

An assignment, grant, or conveyance of any patent or application for patent should be acknowledged before a notary public or officer authorized to administer oaths or perform notarial acts. The certificate of such acknowledgement constitutes prima facie evidence of the execution of the assignment, grant, or conveyance.

RECORDING OF ASSIGNMENTS

The Patent Office records assignments, grants and similar instruments sent to it for recording and the recording serves as notice. If an assignment, grant, or conveyance of a patent or an interest in a patent (or an application for patent) is not recorded in the Patent Office within 3 months from its date, it is void against a subsequent purchaser for a valuable consideration without notice, unless it is recorded prior to the subsequent purchase.

An instrument relating to a patent should identify the patent by number and date (the name of the inventor and title of the invention as stated in the patent should also be given). An instrument relating to an application should identify the application by its serial number and date of filing, and the name of the inventor and title of the invention as stated in the application should also be given. Sometimes an assignment of an application is executed at the same time that the application is prepared and before it has been filed in the Patent Office. Such assignment should adequately identify the application, as by its date of execution and name of the inventor and title of the invention, so that there can be no mistake as to the application intended.

If an application has been assigned and the assignment is recorded on or before the date the final fee is paid, the patent will be issued to the assignee as owner. If the assignment is of a part interest only, the patent will be issued to the inventor and assignee as joint owners.

JOINT OWNERSHIP

Patents may be owned jointly by two or more persons as in the case of a patent granted to joint inventors, or in the case of the assignment of a part interest in a patent. Any joint owner of a patent, no matter how small his part interest, may make, use, and sell the invention for his own profit, without regard to the other owner, and may sell his interest or any part of it, or grant licenses to others, without regard to the other joint owner, unless the joint owners have made a contract governing their relation to each other. It is accordingly dangerous to assign a part interest without a definite agreement between the parties

as to the extent of their respective rights and their obligations to each other if the above result is to be avoided.

The owner of a patent may grant licenses to others. Since the patentee has the right to exclude others from making, using or selling the invention, no one else may do any of these things without his permission. A license is the permission granted by the patent owner to another to make, use, or sell the invention. No particular form of license is required; a license is a contract and may include whatever provisions the parties agree upon, including the payment of royalties, etc.

The drawing up of a license agreement (as well as assignments) is within the field of an attorney at law, although such attorney should be familiar with patent matters as well. A few States have prescribed certain formalities to be observed in connection with the sale of patent rights.

INFRINGEMENT OF PATENTS

Infringement of a patent consists in the unauthorized making, using, or selling of the patented invention within the territory of the United States, during the term of the patent. If a patent is infringed, the patentee may sue for relief in the appropriate Federal court. He may ask the court for an injunction to prevent the continuation of the infringement, and he may also ask the court for an award of damages because of the infringement. In such an infringement suit, the defendant may raise the question of the validity of the patent, which is then decided by the court. The defendant may also aver that what he is doing, does not constitute infringement. Infringement is determined primarily by the language of the claims of the patent and, if what the defendant is making does not fall within the language of any of the claims of the patent, he does not infringe.

Suits for infringement of patents follow the rules of procedure of the Federal courts. From the decision of the district court, there is an appeal to the appropriate Federal court of appeals. The Supreme Court may thereafter take a case by writ of certiorari. If the United States Government infringes a patent, the patentee has a remedy for damages in the Court of Claims of the United States. The Government may use any patented invention without permission of the patentee, but the patentee is entitled to obtain compensation for the use by or for the Government.

If the patentee notifies anyone that he is infringing his patent or threatens suit, the one charged with infringement may himself start the suit in a Federal court and get a judgment on the matter.

The Patent Office has no jurisdiction over questions relating to infringement of patents. In examining applications for patent no de-

termination is made as to whether the invention sought to be patented infringes any prior patent. An improvement invention may be patentable, but it might infringe a prior unexpired patent for the invention improved upon, if there is one.

PATENT MARKING AND "PATENT PENDING"

A patentee who makes or sells patented articles, or a person who does so under him, is required to mark the articles with the word "Patent" and the number of the patent. The penalty for failure to mark is that the patentee may not recover damages from an infringer unless the infringer was duly notified of the infringement and continued to infringe after the notice.

The marking of an article as patented when it is not in fact patented is against the law and subjects the offender to a penalty.

Some persons mark articles sold with the terms "Patent Applied For" or "Patent Pending." These phrases have no legal effect, but only give information that an application for patent has been filed in the Patent Office. The protection afforded by a patent does not start until the actual grant of the patent. False use of these phrases or their equivalents is prohibited.

DESIGN PATENTS

The patent laws provide for the granting of design patents to any person who has invented any new, original and ornamental design for an article of manufacture. The design patent protects only the appearance of an article, and not its structure or utilitarian features. The proceedings relating to granting of design patents are the same as those relating to other patents with a few differences. A design patent may be granted for the term of 3½ years, or for 7 years, or for 14 years, as the applicant may elect. The fee for each of the three terms is different. If the applicant requests a design patent for one of the shorter terms, he is permitted to change his application to one of the longer terms at any time before the application is allowed upon payment of the balance of the fee required.

The drawing of the design patent conforms to the same rules as other drawings, but no reference characters are required.

The specification of a design application is short and ordinarily follows a set form. Only one claim is permitted, following a set form.

PLANT PATENTS

The law also provides for the granting of a patent to anyone who has invented or discovered and asexually reproduced any distinct and new variety of plant other than a tuber-propagated plant.

Asexually propagated plants are those that are reproduced by means other than from seeds, such as by the rooting of cuttings, by layering, budding, grafting, inarching, etc.

With reference to tuber-propagated plants, for which a plant patent cannot be obtained, the term "tuber" is used in its narrow horticultural sense as meaning a short, thickened portion of an underground branch. Such plants covered by the term "tuber-propagated" are the Irish potato and the Jerusalem artichoke. This exception is made because this

group alone, among asexually reproduced plants, is propagated by the same part of the plant that is sold as food.

The same interpretation is given to the words "invented or discovered" and "new" in connection with plants as is given in connection with the other classes of patentable subject matter. The applicant for a patent on a particular plant variety must have done something to create or produce such plant variety, which must also be distinct and new. Thus, a plant found by a person is not considered patentable.

An application for a plant patent consists of the same parts as other applications.

The application papers for a plant patent must be filed in duplicate (to provide an original and duplicate file) but only one need be signed and executed: the second copy may be a legible carbon copy of the original. The reason for thus providing an original and duplicate file is that the duplicate file is utilized for submission to the Department of Agriculture for a report on the plant variety, the original file being retained in the Patent Office at all times.

The specification should include a complete detailed description of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, expressed in botanical terms in the general form followed in standard botanical text books or publications dealing with the varieties of the kind of plant involved (evergreen tree, dahlia plant, rose plant, apple tree, etc.), rather than a mere broad nonbotanical characterization such as commonly found in nursery or seed catalogs. The specification should also include the origin or parentage of the plant variety sought to be patented and must particularly point out where and in what manner the variety of plant has been asexually reproduced. Where color is a distinctive feature of the plant the color should be positively identified in the specification by reference to a designated color as given by a recognized color dictionary.

A plant patent is granted on the entire plant. It therefore follows that only one claim is necessary and only one is permitted.

The oath required of the applicant in addition to the averments required in the oath for other patents must include the averment that the applicant has asexually reproduced the new plant variety.

Plant patent drawings are not mechanical drawings and should be artistically and competently executed. The drawing must disclose all the distinctive characteristics of the plant capable of visual representation. When color is a distinguishing characteristic of the new variety, the drawing must be in color. Two duplicate copies of color drawings must be submitted. Color drawings may be made either in permanent water color or oil, or in lieu thereof may be photographs made by color photography or properly colored on sensitized paper. The paper in any case must correspond in size, weight, and quality to the paper required for other drawings. Mounted photographs are not acceptable.

Specimens of the plant variety, its flower or fruit, should not be submitted unless specifically called for by the examiner.

All inquiries relating to plant patents should be directed to the Patent Office and not to the Department of Agriculture.

The proceedings relating to plant patents are the same as those relating to other patents (not design patents) with a few variations.

Responsive papers to any action in a plant patent application should be in duplicate, and only one need be signed.

FOREIGN PATENTS

Since the rights granted by a United States patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in other countries must apply for a patent in the other countries. Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country, in accordance with the requirements of that country.

The laws of many countries differ in various respects from the patent law of the United States and even from each other. In most foreign countries, publication of the invention before the date of the application will bar the right to a patent. In most foreign countries, a series of fees are due after the grant of the patent; these fees are usually annual and increase in amount each year. Most foreign countries require that the patented invention must be manufactured in that country after a certain period, usually 3 years. If there is no manufacture within this period in some countries, the patent may be void, while in most countries the patent may be subject to the grant of compulsory licenses to any other person who may apply for a license.

There is a treaty relating to patents to which over forty countries have subscribed, which provides that each country guarantees to the citizens of the other countries the same rights in patent matters that it gives to its own citizens. This treaty also provides that if an application for patent is filed in one of the countries and then an application is filed in a second country within 1 year from the first, the second application will be given the benefit of the filing date of the first application. This is known as the right of priority. Thus one who files an application for patent in the United States, and then files in one of these countries within 12 months, is credited with his United States filing date in the foreign country.

The Patent Office cannot assist in the filing of applications for patents in foreign countries. A number of patent attorneys specialize in obtaining patents in foreign countries for American clients. In general, an inventor should be satisfied that he could make some profit from foreign patents or that there is some particular reason for obtaining them, before he attempts to apply for foreign patents.

Under United States law it is necessary, in the case of inventions made in the United States, to obtain a license from the Commissioner of Patents before applying for a patent in a foreign country, in certain cases. Such a license is required if the foreign application is filed before the expiration of 6 months from the filing of an application in the United States. The request for a license may be a simple letter referring to the United States application. After 6 months from the United States filing, a license is not required unless the invention has been ordered to be kept secret.

FOREIGN APPLICANTS FOR UNITED STATES PATENTS

The patent laws of the United States make no discrimination with respect to the citizenship of the inventor. Any inventor, regardless of his citizenship, may apply for a patent on the same basis as an American citizen. There are, however, a number of particular points of special interest to applicants located in foreign countries.

The application for patent in the United States must be made by the inventor and the inventor must sign the papers (with certain exceptions), differing from the law in many countries where the signature of the inventor and an oath of inventorship are not necessary. If the inventor is dead, the application may be made by his executor or administrator, or equivalent, and in case of mental disability it may be made by his legal representative (guardian).

No United States patent can be obtained if the invention was patented abroad before applying in the United States by the inventor or his legal representatives or assigns on an application filed more than 12 months before filing in the United States. Six months are allowed in the case of a design patent.

An application for patent filed in the United States by any person who has previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges to citizens of the United States shall have the same force and effect for the purpose of overcoming intervening acts of others as if filed in the United States on the date on which the application for patent for the same invention was first filed in such foreign country, provided the application in the United States is filed within 12 months (6 months in the case of a design patent) from the earliest date on which any such foreign application was filed. A copy of the foreign application certified by the patent office of the country in which filed is required to secure this right of priority.

If any application for patent has been filed in any foreign country by the applicant or by his legal representatives or assigns prior to his application in the United States, the applicant must, in the oath accompanying the application, state the country in which the earliest such application has been filed, giving the date of filing the application; and all applications filed more than a year before the filing in the United States must also be recited in the oath.

An oath or affirmation must be taken to every application; a mere acknowledgment or verification of the signature before a magistrate is not sufficient. When the applicant is in a foreign country the oath or affirmation may be made before any diplomatic or consular officer of the United States, or before any officer having an official seal and authorized to administer oaths in the foreign country, whose authority shall be proved by a certificate of a diplomatic or consular officer of the United States, the oath being attested in all cases by the proper official seal of the officer before whom the oath or affirmation is made.

When the oath is taken before an officer in the country foreign to the United States all the application papers (except the drawing) must be attached together and a ribbon passed one or more times through all the sheets of the application, and the ends of the ribbon

brought together under the seal before the latter is affixed and impressed, or each sheet must be impressed with the official seal of the officer before whom the oath was taken.

If the application is filed by the legal representative (executor, administrator, etc.) of a deceased inventor, the legal representative must make the oath and his authority must be proved by certificate of a diplomatic or consular officer of the United States.

An attorney resident in the United States and specifically familiar with practice in the United States Patent Office should be employed. An attorney not resident in the United States, if on the Patent Office roster of attorneys, may act, and correspondence will be addressed to him unless he appoints an associate in the United States.

FEES AND PAYMENT OF MONEY

The following fees and charges are payable to the Patent Office:

1. Filing fee. On filing each original application for a patent having 20 claims or less, except in design cases	$30.00
For each additional claim over 20	1.00
2. Final fee. On issuing each original patent having 20 claims or less, except in design cases	30.00
For each additional claim over 20	1.00
3. Filing fee, designs. In design cases:	
For term of 3 years and 6 months	10.00
For term of 7 years	15.00
For term of 14 years	30.00
4. Filing fee, reissues. On every application for the reissue of a patent	30.00
For each claim which is in excess of 20 as well as in excess of the number of claims in the original patent	1.00
5. On filing each petition for the revival of an abandoned application for patent	10.00
6. On filing each petition for the delayed payment of the final fee	10.00
7. On an appeal for the first time from the primary examiner to the Board of Appeals	25.00
8. On filing each disclaimer	10.00
9. For certification of copies of records, etc., in any case, in addition to the cost of copy certified	1.00
10. For typewritten manuscript copies of records, for every 100 words or fraction thereof	.10
11. For photostat copies of records or printed material, per sheet	.30
12. For photoprints of drawings, for each sheet of drawing	.30
13. For uncertified printed copies of the specifications and accompanying drawings of patents, except design patents, if in print, each	.25
15. For uncertified printed copies of design patents, if in print	.10
16. For recording every assignment, agreement, or other paper, not exceeding six pages	3.00
For each additional patent or application included or involved in one writing, where more than one is so included or involved, additional	.50
For each additional two pages or less	1.00
17. For abstracts of title to each patent or application, minimum charge	3.00
19. For translations, made only of references cited in applications or of papers filed in the Office, for every 100 words or fraction thereof	1.25
22. For making drawings, when they can be made by the Patent Office, the cost of making the same, minimum charge per sheet	15.00
23. For correcting drawings, the cost of making the correction, minimum charge	1.00
24. For the mounting of unmounted drawings and photoprints received with patent applications, provided they are of approved permanency	1.00
29. Lists of United States patents classified in a subclass, made to order, per sheet (containing 100 patent numbers or less)	.20
31. For certificate of correction of applicant's mistake	10.00

The following publications are sold, and the prices for them fixed, by the Superintendent of Documents, Government Printing Office, Washington 25, D. C., to whom all communications respecting the same should be addressed:

Official Gazette of the United States Patent Office:	
Annual subscription, domestic	$30.00
Annual subscription, foreign	38.50
Single numbers	.75
Annual Index Relating to Patents, price varies.	
Decisions of the Commissioner of Patents, price varies.	
Manual of Classification of Patents	9.00
Foreign	12.50
Manual of Patent Examining Procedure	6.25
Foreign	7.50
Rules of Practice of the United States Patent Office in Patent Cases	.50
Rules of Practice in Trade-Mark Cases, with Forms and Statutes	.50
Patent Laws	.25
Roster of Attorneys and Agents Registered to Practice before the United States Patent Office	1.00
Guide for Patent Draftsmen	.15

All payment of money required for Patent Office fees should be made in United States specie, Treasury notes, national bank notes, post office money orders or postal notes payable in Washington, D. C., or by certified checks. If sent in any other form, the Office may delay or cancel the credit until collection is made. Postage stamps are not acceptable. Money orders and checks must be made payable to the Commissioner of Patents. Remittances from foreign countries must be payable and immediately negotiable in the United States for the full amount of the fee required.

Money paid by actual mistake or in excess, such as a payment not required by law, will be refunded, but a mere change of purpose after the payment of money, as when a party desired to withdraw his application for a patent or to withdraw an appeal, will not entitle a party to demand such a return. Amounts of ten cents or less will not be returned unless specifically demanded, within a reasonable time, nor will the payer be notified of such amount; amounts over 10 cents but less than $1 may be returned in postage stamps, and other amounts by check.

FORMS

The following forms illustrate the manner of preparing parts of applications for patent and other papers. Additional forms are given in the Rules of Practice. Forms for patent specifications and drawings are not given since these vary so considerably. Specifications and drawings of patents may be inspected and studied in those libraries which maintain collections of patents (see p. 5), particular patents of interest can be located from the Official Gazette (see p. 6) and copies purchased:

1. Patent Application, sole inventor; petition and oath.
2. Patent Application, joint inventors; petition and oath.
3. Patent Application, Administrator of estate of deceased inventor; petition and oath.
4. Oath not accompanying application.
5. Design application: Petition, specification, oath.

6. Plant patent application, petition and oath.
7. Power of attorney or authorization of agent, not accompanying application.
8. Revocation of power of attorney or authorization of agent.
9. Assignment of patent.
10. Assignment of application.

1. PATENT APPLICATION, SOLE INVENTOR; PETITION, POWER OF ATTORNEY, OATH

TO THE COMMISSIONER OF PATENTS:

Your petitioner, _____, a citizen of the United States and a resident of _____, State of _____, whose post-office address is _____, prays that letters patent may be granted to him for the improvement in _____, set forth in the following specification; and he hereby appoints _____, of _____ _____, (Registration No. _____), his attorney (or agent) to prosecute this application and to transact all business in the Patent Office connected therewith. (If no power of attorney is to be included in the application, omit the appointment of the attorney.)

[The specification, which includes the description of the invention and the claims, is written here.]

_____, the above-named petitioner, being sworn (or affirmed), deposes and says that he is a citizen of the United States and resident of _____, State of _____, that he verily believes himself to be the original, first, and sole inventor of the improvement in _____ _____ described and claimed in the foregoing specification; that he does not know and does not believe that the same was ever known or used before his invention thereof, or patented or described in any printed publication in any country before his invention thereof, or more than one year prior to this application, or in public use or on sale in the United States for more than one year prior to this application; that said invention has not been patented in any country foreign to the United States on an application filed by him or his legal representatives or assigns more than twelve months prior to this application; and that no application for patent on said invention has been filed by him or his representatives or assigns in any country foreign to the United States, except as follows _____

_____
(Inventor's full signature)

STATE OF _____, }
County of _____, } *ss:*

Sworn to and subscribed before me this _____ day of _____, 19__.
[SEAL]

_____
(Signature of notary or officer)

_____
(Official character)

2. PATENT APPLICATION, JOINT INVENTORS: PETITION, POWER OF ATTORNEY, OATH

TO THE COMMISSIONER OF PATENTS:

Your petitioners, _____ and _____, citizens of the United States and residents, respectively, of _____, State of _____, and of _____, State of _____, whose post-office addresses are, respectively, _____ and _____ pray that letters patent may be granted to them, as joint inventors, for the improvement in _____, set forth in the following specification; and they hereby appoint _____, of _____ (Registration No. _____), their attorney (or agent), to prosecute this application and to transact all business in the Patent Office connected therewith. (If no power of attorney is to be included in the application, omit the appointment of the attorney.)

[The specification, which includes the description of the invention and the claims, is written here.]

_____ and _____, the above-named petitioners, being sworn (or affirmed), depose and say that they are citizens of the United States, and residents of _____, State of _____, that they verily believe themselves to be the original, first and joint inventors of the improvement in _____ described and claimed in the foregoing specification; that they do not know and do not believe that the same was ever known or used before their invention thereof, or patented or described

in any printed publication in any country before their invention thereof, or more than one year prior to this application, or in public use or on sale in the United States for more than one year prior to this application; that said invention has not been patented in any country foreign to the United States on an application filed by them or their legal representatives or assigns more than 12 months prior to this application; and that no application for patent on said invention has been filed by them or their representatives or assigns in any country foreign to the United States, except as follows: _____

_____

_____

(Inventors' full signatures)

STATE OF _____ }
County of _____ } *ss:*

Sworn to and subscribed before me this _____ day of _____, 19__.

_____

(Signature of notary or officer)

[SEAL]

_____

(Official character)

3. PATENT APPLICATION, ADMINISTRATOR OF DECEASED INVENTOR: PETITION, POWER OF ATTORNEY, OATH

TO THE COMMISSIONER OF PATENTS:

Your petitioner, A _____ B _____, a citizen of the United States and a resident of _____, State of _____, whose post-office address is _____, administrator of the estate of C _____ D _____, late a citizen of the United States and a resident of _____, State of _____, deceased (as by reference to the duly certified copy of letters of administration, hereto annexed, will more fully appear), prays that letters patent may be granted to him for the invention of the said C _____ D _____ for the improvement in _____, set forth in the following specification; and he hereby appoints _____, of _____ (Registration No. _____), his attorney (or agent), to prosecute this application and to transact all business in the Patent Office connected therewith.

(If no power of attorney is to be included in the application, omit the appointment of the attorney.)

[The specification, which includes the description of the invention and the claims, is written here.]

A _____ B _____, the above-named petitioner, being sworn (or affirmed), deposes and says that he is a citizen of the United States of America and a resident of _____, that he is the administrator of the estate (or executor of the last will and testament) of C _____ D _____, deceased, late a citizen of the United States and resident of _____, that he verily believes the said C _____ D _____ to be the original, first and sole inventor of the improvement in _____ described and claimed in the foregoing specification; that he does not know and does not believe that the same was ever known or used before the invention thereof by the said C _____ D _____, or patented or described in any printed publication in any country before the said invention thereof, or more than one year prior to this application, or in public use or on sale in the United States for more than one year prior to this application; that said invention has not been patented in any country foreign to the United States on an application filed by the said C _____ D _____ or his legal representatives or assigns more than 12 months prior to this application; and that no application for patent on said invention has been filed by the said C _____ D _____ or his representatives or assigns in any country foreign to the United States, except as follows: _____

A _____ B _____

(Signature)

ADMINISTRATOR, ETC.

STATE OF _____ }
County of _____ } *ss:*

Sworn to and subscribed before me this _____ day of _____, 19__.

_____

(Signature of notary or officer)

[SEAL]

_____

(Official character)

4. OATH NOT ACCOMPANYING APPLICATION

STATE OF _____ } ss:
County of _____ }

_____, being sworn (or affirmed), deposes and says that he is a citizen of the United States of America and resident of _____, that on _____, 19____, he filed application for patent Serial No. _____ in the United States Patent Office, that he verily believes himself to be the original, first and sole inventor or the improvement in _____ described and claimed in the specification of said application for patent; that he does not know and does not believe that the same was ever known or used before his invention thereof, or patented or described in any printed publication in any country before his invention thereof, or more than one year prior to the date of said application, or in public use or on sale in the United States for more than one year prior to the date of said application; that said invention has not been patented in any country foreign to the United States before the date of said application on an application filed by him or his legal representatives or assigns more than twelve months prior to the date of said application; and that no application for patent on said invention has been filed by him or his representatives or assigns in any country foreign to the United States, except as follows: _____

_____
(Inventor's full signature)

Sworn to and subscribed before me this _____ day of _____, 19__.

_____
(Signature of notary or officer)

[SEAL]

_____
(Official character)

5. DESIGN APPLICATION

TO THE COMMISSIONER OF PATENTS:

Your petitioner, _____, a citizen of the United States and a resident of _____ in the county of _____ and State of _____, whose post-office address is _____, city of _____, State of _____, prays that letters patent may be granted to him for the term of 3½ years (or 7 years or 14 years) for the new and original design for _____ set forth in the following specification; and he hereby appoints, _____, of _____, (Registration No. _____), his attorney (or agent), to prosecute this application and to transact all business in the Patent Office connected therewith.

Be it known that I have invented a new, original, and ornamental design for _____ of which the following is a specification, reference being had to the accompanying drawing, forming a part hereof.

The figure is a plan view of a _____, showing my new design.

I claim.

The ornamental design for a _____, as shown.

_____, the above-named petitioner being sworn (or affirmed), deposes and says that he is a citizen of the United States and resident of county of _____, State of _____, that he verily believes himself to be the original, first, and sole inventor of the design for _____ described and claimed in the foregoing specification; that he does not know and does not believe that the same was ever known or used before his invention thereof, or patented or described in any printed publication in any country before his invention thereof, or more than one year prior to this application, or in public use or on sale in the United States for more than one year prior to this application; that said design has not been patented in any country foreign to the United States on an application filed by him or his legal representatives or assigns more than 6 months prior to this application; and that no application

for patent on said design has been filed by him or his representatives or assigns in any country foreign to the United States, except as follows: _____

_____
(Inventor's full signature)

STATE OF _____
County of _____ } *ss:*

Sworn to and subscribed before me this _____ day of _____, 19___.

_____
(Signature of notary or officer)

[SEAL]

_____
(Official Character)

6. PLANT PATENT APPLICATION: PETITION, POWER OF ATTORNEY, OATH

TO THE COMMISSIONER OF PATENTS:

Your petitioner, _____, a citizen of the United States and a resident of _____, in the State of _____, whose post-office address is _____, prays that letters patent may be granted to him for the new and distinct variety of _____, set forth in the following specification; and he hereby appoints _____, of _____ (Registration No. _____), his attorney (or agent), to prosecute this application and to transact all business in the Patent Office connected therewith.

(If no power of attorney is to be included in the application, omit the appointment of the attorney.)

[The specification, which includes the description of the invention and the claims, is written here.]

_____, the above-named petitioner, being sworn (or affirmed), deposes and says that he is a citizen of the United States of America and resident of _____, that he verily believes himself to be the original, first, and sole inventor of the new and distinct variety of _____ described and claimed in the foregoing specification; that he has asexually reproduced the said new and distinct variety; that he does not know and does not believe that the same was ever known or used before his invention thereof, or patented or described in any printed publication in any country before his invention thereof, or more than one year prior to this application, or in public use or on sale in the United States for more than one year prior to this application; that said invention has not been patented in any country foreign to the United States on an application filed by him or his legal representatives or assigns more than 12 months prior to this application; and that no application for patent on said new and distinct variety has been filed by him or his representatives or assigns in any country foreign to the United States, except as follows: _____

_____
(Inventor's full signature)

STATE OF _____
County of _____ } *ss:*

Sworn to and subscribed before me this _____ day of _____, 19___.

_____
(Signature of notary or officer)

[SEAL]

_____
(Official character)

7. POWER OF ATTORNEY OR AUTHORIZATION OF AGENT, NOT ACCOMPANYING APPLICATION

TO THE COMMISSIONER OF PATENTS:

The undesigned having, on or about the _____ day of _____, 19___, made application for letters patent for an improvement in _____, Serial Number _____, hereby appoints _____ of _____, State of _____, Registration No. _____, his attorney (or agent), to prosecute said application, and to transact all business in the Patent Office connected therewith.

_____
(Signature)

8. REVOCATION OF POWER OF ATTORNEY OR AUTHORIZATION OF AGENT

To the Commissioner of Patents:

The undersigned having, on or about the _____ day of _____, 19__, appointed _____, of _____, State of _____, his attorney (or agent) to prosecute an application for letters patent which application was filed on or about the _____ day of _____, 19__, for an improvement in _____, Serial Number _____, hereby revokes the power of attorney (or authorization of agent) then given.

_____
(Signature)

9. ASSIGNMENT OF PATENT

(No special form is prescribed for assignments, which may contain various provisions depending upon the agreement of the parties. The following two forms are specimens of assignments which have been used in some cases.)

Whereas, I, _____, of _____, did obtain Letters Patent of the United States for an improvement in _____ No. _____, dated _____; and whereas, I am now the sole owner of said patent; and,

Whereas, _____, of _____, whose post-office address is _____, City of _____, and State of _____, is desirous of acquiring the entire interest in the same;

Now, therefore, in consideration of the sum of _____ dollars ($_____), the receipt of which is hereby acknowledged, and other good and valuable considerations, I, _____, by these presents do sell, assign, and transfer unto the said _____, the entire right, title, and interest in and to the said Letters Patent aforesaid; the same to be held and enjoyed by the said _____, for his own use and behoof, and for his legal representatives and assigns, to the full end of the term for which said Letters Patent are granted, as fully and entirely as the same would have been held by me had this assignment and sale not been made.

Executed, this _____ day of _____, 19__, at _____.

_____

State of _____, }
County of _____ } *ss:*

Before me personally appeared said _____ and acknowledged the foregoing instrument to be his free act and deed this _____ day of _____, 19__

_____
[seal] (Notary Public)

10. ASSIGNMENT OF APPLICATION

Whereas, I, _____, of _____ have invented certain new and useful Improvements in _____, for which an application for United States Letters Patent was filed on _____, Serial No. _____, [if the application has been prepared but not yet filed, state "for which an application for United States Letters Patent was executed on _____," instead] and

Whereas, _____, of _____, whose post-office address is _____, is desirous of acquiring the entire right, title and interest in the same;

Now, therefore, in consideration of the sum of _____ dollars ($_____), the receipt whereof is hereby acknowledged, and other good and valuable consideration, I, the said _____, by these presents do sell, assign and transfer unto said _____, the full and exclusive right to the said invention in the United States and the entire right, title, and interest in and to any and all Letters Patent which may be granted therefore in the United States.

I hereby authorize and request the Commissioner of Patents to issue said Letters Patent to said _____, as the assignee of the entire right, title, and interest in and to the same, for his sole use and behoof; and for the use and behoof of his legal representatives, to the full end of the term for which

said Letters Patent may be granted, as fully and entirely as the same would have been held by me had this assignment and sale not been made.

Executed this _____ day of _____, 19__, at _____

_____

STATE OF _____,
County of _____, } *ss:*

Before me personally appeared said _____ and acknowledged the foregoing instrument to be his free act and deed this _____ day of _____, 19__.

_____

[SEAL] (Notary Public)

U. S. GOVERNMENT PRINTING OFFICE: 1934

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This case should be reviewed here since it involves a very obvious and special showing of error and special and important reasons for granting certiorari. It does not involve merely a determination of a question of fact as stated by respondent 7

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IN THE

Supreme Court of the United States

October Term, 1955

No. 190

CHARLES F. RUBSAM,

Petitioner,

vs.

HARLEY C. LONEY COMPANY,

Respondent.

Supplemental Argument in Support of Petition for Writ of Certiorari.

Petitioner, Charles F. Rubsam, prays that permission be granted for the filing of the within Supplemental Argument in support of his Petition for Writ of Certiorari in the above proceedings. This request is based upon the ground that Petitioner, at his advanced age of seventy-nine years, has been confined in the Santa Barbara Cottage Hospital, Santa Barbara, California, for the purpose of undergoing major surgery, and during said hospital confinement, Petitioner secured counsel to assist him in the within proceedings and has been advised by said counsel, Percy C. Heckendorf, of Santa Barbara, California, that certain fundamental, vital and turning points involved in the within proceedings should be more

clearly and definitely presented to this Court in order that there be no further miscarriage of justice in connection with a final determination of Petitioner's cause.

Statement of the Case.

This is a contract action based upon certain patent license agreements granting exclusive rights to the Petitioner, Charles F. Rubsam, upon certain patents relating to balancing weights for automobiles, in the so-called original "production field," that is, by motor car manufacturers, excepting therefrom the "service field." Petitioner sought injunctive relief in the lower court against the invasion of his exclusive license by Respondent, an accounting for unpaid royalties, and assessment of costs. The Respondent answered, admitting the execution of contract Exhibit A, but alleged that it merely granted a restricted license when construed in conjunction with Defendant's Exhibit 1 [R. 21].

The scope and validity of the patents was directly involved as an issue in the proceedings below. The importance of this as one of the controlling points will be enlarged upon in this argument, in view of the fact that it involves an important Federal question concerning United States Patent Law.

Wheel balancing weights are sold in the "production field" for use in the auhtomobile manufacturing plant. Weights sold in the "service field" are sold to wholesalers who resell to retailers who balance wheels at the retail level, incuding operators of tire stores, garages and other automobile service establishments. Every car owner knows about the periodical necessity of having his wheels re-balanced in said establishments.

One of the basic and controlling questions in the present controversy is whether or not Respondent owes royalties to the Petitioner on the basis of one-half cent per balance weight for all balance weights sold by Respondent in the "production field" since January 1, 1948, under an express contract in writing contained in the following four documents which were presented to the lower courts and are designated as follows: Plaintiff's Exhibit A [R. 4]; Plaintiff's Exhibit B [R. 6]; Plaintiff's Exhibit C [R. 9]; Defendant's Exhibit 1 [R. 21].

The two lower courts' decisions concuded that Respondent did not owe royalties claimed by Petitioner.

The case turns upon contract and patent law and not upon the determination of a fact as contended by Respondent. In tnis connection, the courts below were not fully and adequately advised of the importance and significance of the contract law and patent law involved in this case as a result of two vital factors which had taken place prior to the trial and decision in the lower courts. These two factors are: (1) That on November 5, 1945, Judge Swigert in the Federal Court at Hammond, Indiana, held the Du Sang Patent, No. 2,029,561, invalid and that decision was affirmed by the Seventh Circuit Court of Appeals June 23, 1947; (2) The Turner Manufacturing Company as assignee and successor to the Du Sang Patent, on July 23, 1947, filed a disclaimer following the decision of Judge Swigert, as affirmed by the Circuit Court, that the patent involved was invalid. Finally, the "Official Gazette" of the United States Patent Office, which was then conducted under Commissioner Casper W. Ooms, one of the attorneys for Respondent, in its weekly issue of August 26, 1947,

contained a published statement of the disclaimer by Turner Manufacturing Company, filed July 23, 1947, as assignee of the Du Sang Patent [Pltf. Ex. E-1, R. following p. 142].

On this point in the case, Respondent depended upon Defendant's Exhibit 1 [R. 21], as a defense to the recovery of royalties by the Petitioner. Respondent's position was based upon the contention that Defendant's Exhibit 1, contained an exception which did not require the royalty payments for the wheel balancing weights involved and that all rights had been given to Du Sang.

However, up to January 1, 1948, all royalty payments has been made by Respondent to Petitioner in full recognition of the fact that the royalties were properly due Petitioner pursuant to his agreement expressed in Plaintiff's Exhibit A [R. 4]; Plaintiff's Exhibit B [R. 6]; Plaintiff's Exhibit C [R. 9], and Defendant's Exhibit 1 [R. 21]. This admission of responsibility and liability under the agreement was expressed in December, 1947, in a letter from Respondent to the Petitioner and also in November, 1947, in a letter from Respondent's attorneys to General Motors Corporation, both of which are cited on page 12 of the Petition for a Writ of Certiorari.

The first time any question arose as to the liability of Respondent to pay said royalties to Petitioner was raised as the result of an opinion rendered by Casper W. Ooms, former Commissioner of Patents, and as attorney for the Harley C. Loney Company, on February 12,

1948, to the effect that the Loney Company was not obligated to pay royalties to Petitioner upon the cast on balancing weights upon which Du Sang held so-called exclusive rights. In that opinion [Pltf. Ex. MMM, R. 98-102], which omits to mention at its outset the assignments [Exs. 2, G and I], as referred to on page 5, top of Petitioner's Reply, it is important to note that Mr. Ooms made the following statement:

> "I am not aware of any circumstances which in any way modify this conclusion." [R. 102 middle.]

On February 12, 1948, the date upon which said opinion was written by Mr. Ooms, a public record had been made of the fact that Judge Swigert on November 5, 1945, had held the Du Sang Patent invalid and that his decision was affirmed in the Seventh Circuit on June 23, 1947, and that on July 23, 1947, the Turner Manufacturing Company, as assignee of the Du Sang Patent, had disclaimed under that patent and finally the "Official Gazette" of the United States Patent Office under the direction of Mr. Ooms, contained, on August 26, 1947, a published statement of the disclaimer under the Du Sang Patent. It is remarkable that Mr. Ooms could state that he knew of no circumstances which in any way would modify his opinion in view of the above record in connection with the invalidity of the Du Sang Patent, upon which the entire defense on this point rests. Respondent in this connection claimed that the document [Deft. Ex. 1, R. 21] excluded royalties under the Du Sang Patent. This could not be true for an invention which

has been disclaimed after having been held invalid, and which has become public property under United States patent law.

As a result of the Ooms opinion of February 12, 1948, no royalty payments were further made by Respondent to Petitioner, and on April 26, 1949, Petitioner filed the present action in the District Court. The answer of Respondent is based upon the validity of the Du Sang Patent and, as heretofore indicated, the validity of that patent was directly involved in this proceeding.

At the trial while Petitioner was testifying and had mentioned the fact that he had been informed of Judge Swigert's decision holding the Du Sang Patent invalid, Judge Thornton immediately asked the question: "When was that?" [R. 194 top], and after Petitioner stated that the date was November 5, 1945, he was shut off by objections from Mr. Ooms from further explaining the details in connection with the invalidity of the patent. It is obvious that the court realized the significance of the prior decision holding the Du Sang Patent invalid, in view of the fact that Respondent based its defense in this aspect of the case upon the validity of the Du Sang Patent and the exceptions purportedly contained in Defendant's Exhibit 1 [R. 21]. Nevertheless, the Court erroneously ruled that it was not an issue in the case [R. 44, middle].

ARGUMENT.

This Case Should Be Reviewed Here Since It Involves a Very Obvious and Special Showing of Error and Special and Important Reasons for Granting Certiorari. It Does Not Involve Merely a Determination of a Question of Fact as Stated by Respondent.

This case involves two important questions of law: *First:* A determination of the legal effect of the agreements relied upon by the parties hereto; and *Second:* A determination of the legal effect of the invalidity of the Du Sang Patent upon those agreements.

The question of the invalidity of a patent and its effect upon existing patent license agreements is of vital importance in the field of patent law and requires a determination by this Court in order that there may be uniformity in this aspect of patent law.

It is obvious that the importance of the validity or invalidity of the Du Sang Patent cannot be overemphasized for the reason that it is not reasonable to expect that Petitioner and Respondent would have entered into the agreement, Defendant's Exhibit 1 [R. 21], except upon the basis that the Du Sang Patent was valid, and secondly, that Petitioner would have set aside to him the entire "production field," and have excepted from the agreement the "service field" only. It is unreasonable to believe that Petitioner, after having conceded priority in contract [Ex. A; R. 4], would have entered into such an agreement excepting both the production and service fields from his operations as now contended by Respondent.

That agreement clearly and explicitly allocated the entire field by assignment the "production field" to Petitioner and by excepting the "service field" for Respondent. There was no other basic purpose for the agreement. Its contemporaneous construction by Petitioner and Respondent so indicates, since Respondent paid royalties thereunder up to January 1, 1948, and only stopped paying after receiving the Ooms opinion of February 12, 1948 [Pltf. Ex. MMM, R. 98-102]. Judge Swigert's decision holding the Du Sang Patent invalid, and being sustained on appeal, and finally the disclaimer of the Du Sang Patent by Turner Manufacturing Company completely erases any defense Respondent had to this aspect of the case, and we humbly urge that it was the duty of Respondent and its counsel to fully and fairly apprise not only the two lower courts, but also this Court, of the full significance of the invalidity of the Du Sang Patent upon which their defense rested.

In connection with this failure on the part of the Respondent to fully and fairly disclose all of the facts and circumstances in connection with the invalidity of the Du Sang Patent and its legal effect under contract and patent law, we are constrained to reciprocate the compliment paid by counsel for Respondent to Petitioner, as contained on page 6 of its Brief in Opposition to the Petition for a Writ of Certiorari, wherein counsel states: "The presentation of the clause in the Petition is less than candid." In response thereto, it need merely be stated that Petitioner filed his own brief without the aid of counsel and did not

in any way intend to separate the clauses involved with any design to mislead the Court. However, counsel for Respondent, Casper W. Ooms, as former Commissioner of Patents and now Chairman of the Patent Compensation Board of the Atomic Energy Commission of the United States, has certainly been far less candid with this Court and, in the past, with the two lower courts in this case in failing to fully disclose and emphasize the importance of the invalidity of the Du Sang Patent as determined by Judge Swigert and affirmed by the Circuit Court and by the disclaimer following that decision.

Conclusion.

This case involves important questions of contract and patent law, which should be determined by this Court. It follows as a matter of law from the above record that with the invalidity of the Du Sang Patent, Petitioner was fully entitled to enjoy and enforce all of his property rights acquired under the aforementioned agreements.

The petition should therefore be granted.

Respectfully submitted,

PERCY C. HECKENDORF,
Attorney for Petitioner.

CHARLES F. RUBSAM,
Petitioner.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1955

No. 190

CHARLES F. RUBSAM,

Petitioner

vs.

HARLEY C. LONEY COMPANY,

Respondent

PETITIONER'S BRIEF FOR REHEARING OF ORDER DENYING PETITION FOR WRIT OF CERTIORARI

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PETITIONER'S BRIEF FOR REHEARING OF ORDER DENYING PETITION FOR WRIT OF CERTIORARI

STATEMENT OF GROUNDS

Petitioner, on page 10 top of his Petition for a Writ of Certiorari, referred to the decision in Motor Wheel Corporation vs. Rubsam Corporation, 92 F. 2d 129 (6th Cir.), quoting:

"The interpretation of a patent is a question of law for the Court":

"In a royalty case the contract is limited by the scope of the patents, and the Court must construe them."

This case was decided June 28, 1937 by Judges Hicks, Simons and Allen, and Circuit Judge ALLEN wrote the opinion, stating at the outset that the case involves an Appeal in an action for royalties due under a patent license contract. The present case, Charles F.

Rubsam vs. Harley C. Loney Co., is identical with the former case and was decided on December 20, 1954 in the same Sixth Circuit by Judges Martin, McAllister and Miller. Two identical cases were thus involved in the same Court of Appeals for the Sixth Circuit, and two diametrically opposite decisions were rendered by two different groups of Judges.

Under Rule 19 of this High Court Petitioner could not invoke Paragraph (b) of said Rule because it states that a review on writ of certiorari will be considered only *where a Court of Appeals has rendered a decision in conflict with the decision of another Court of Appeals on the same matter.*

When two different groups of Judges render an opinion in the same Court of Appeals and one decision is in conflict with the other on the same matter, a petitioner should be permitted to invoke a rule which provides that a review on writ of certiorari will be considered where conflicting decisions have been rendered *in the same Court of Appeals.* Petitioner therefore prays that Rule 19 (b) be clarified accordingly and that he receive the benefit of its clarification for the present petition for rehearing.

In the present action for royalties due under a patent license contract, it was mandatory for the District Court and for the Court of Appeals for the Sixth Circuit to follow Judge Allen's ruling. Thus, both courts were bound to rule that the scope of the DuSang patent No. 2,029,561 terminated on July 23, 1947 when the invention of the cast-on type of weight was disclaimed. The inven-

tion became public property after the disclaimer was recorded in the Official Gazette of the United States Patent Office on August 26, 1947.

Thus, the contract, Def. Ex. 1, became ineffective because it was based on the validity of the DuSang patent. It is noteworthy to quote here the explanation given to this Court in Respondent's reply brief on page 6 bottom and page 7 top as follows:

On February 17, 1936, when Rubsam and Hume signed Pl. Ex. A, DuSang certainly owned the exclusive rights to make the cast-on form of weight. He had obtained this in the contract of December 12, 1934 (Def. Ex. 1, R. 21). As to that form of weight, Hume and Respondent were powerless to grant rights to Rubsam. Therefore no rights were granted to Rubsam to the cast-on weight, by Paragraph 2 of Pl. Ex. A (R. 4). All rights to the cast-on weight were specifically excepted by the language which mentions the earlier Hume-DuSang contract (Def. Ex. 1, R. 21).

This statement by Respondent, who knew of the DuSang disclaimer*, was completely untrue because all

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*The Disclaimer as it appears on page 3 of the DuSang Patent No. 2,029,561, Plf' Ex. E-1, reads as follows:

DISCLAIMER

2,029,561.—*Virgil L. DuSang*, Kokomo, Ind. WHEEL BALANCING WEIGHT. Patent dated Feb. 4, 1936. Disclaimer filed July 23, 1947, by the assignee, *Turner Manufacturing Company*. Hereby disclaims claim 1 of said patent.

[*Official Gazette August 26, 1947.*]

rights to the cast-on weight had become public property after July 23, 1947. From then on, Respondent still owed royalty *on the spring clip weight* under the remaining patents owned and controlled by Respondent as Petitioner explained it in the Statement of his original petition on page 3. Petitioner therefore prays that this Court reconsider its order of denial on the basis of Judge Allen's ruling in *Motor Wheel Corporation vs. Rubsam Corporation.*

Petitioner certifies that this petition is restricted to the grounds above specified, is presented in good faith and not for the purpose of delay.

CONCLUSION

Respondent's "Statement of the Case" is contradicted by the evidence as outlined in Petitioner's Conclusion on page 15 of his original petition and Petitioner prays for the Relief as stated in said Conclusion.

November 1955

Respectfully submitted,

CHARLES F. RUBSAM
Pro Se

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1955

No. 190

CHARLES F. RUBSAM,

Petitioner

vs.

HARLEY C. LONEY COMPANY,

Respondent

SUPPLEMENTAL ARGUMENT IN SUPPORT OF PETITION FOR REHEARING OF PETITION FOR WRIT OF CERTIORARI

TO THE CHIEF JUSTICE AND MEMBERS OF THE SUPREME COURT OF THE UNITED STATES:

STATEMENT OF GROUNDS

This is a contract action based upon certain patent license agreements granting exclusive rights to the Petitioner, Charles F. Rubsam, upon five patents owned by Respondent. Petitioner sought injunctive relief against invasion of his exclusive rights, an accounting for unpaid royalties, and assessment of costs.

The scope and validity of all the patents was directly involved. Nevertheless the courts below ruled against Petitioner upon the assumption that the DuSang patent was valid.

Prior to the decisions below the DuSang patent had been held invalid in the Seventh Circuit, and a disclaimer had been made, thus making it public property under the United States Patent Law.

The decisions below did not construe the scope of the patents nor their validity, which is essential in determining the rights under patent license contracts which are limited by the scope of the patents.

The decisions below were based upon the interpretation of the license agreement in connection with one patent, but no determination was made in connection with the remaining patents upon which the original proceeding was based.

The DuSang patent covered the cast-on form of weight, while the remaining patents covered the spring clip weights. Thus, even though the DuSang patent were still in effect and valid, nevertheless the Petitioner would still be entitled to royalties under the remaining patents. The decisions below did not preserve Petitioner's rights in connection with these latter patents. In other words, it is just as vital to rule not only on the limited scope of an invalid patent, but also on the full scope of the remaining valid patents upon which the patent license contract was based.

This same proposition and principle was involved in the case of Motor Wheel Corporation vs. Rubsam Corporation, 92 F. 2nd, 129 (6th Cir.) where the court stated at page 131:

"In a royalty case the contract is limited by the scope of the patents, and the court must construe them. Cf. Western Electric Co. v. Robertson, 142 F. 471 (C.C.A.2); General Motors Corporation v. Swan Carburetor Co., 88 F. (2nd) 876 (C.C.A.6). Here the court ruled upon the scope of the patents."

ARGUMENT

A rehearing should be granted in order to determine the effect and scope of the invalidity of the DuSang patent on the patent license contract, so far as the cast-on wheel balancing weights were concerned; and for further purpose of determining the full scope of the several valid remaining patents for which royalties are due Petitioner, so far as the spring clip wheel balancing weights were concerned.

A rehearing likewise should be granted for the purpose of resolving a conflict in the application of the above patent law principles in the same Circuit wherein diametrically opposite decisions were rendered in connection with Petitioner's patent license royalty contracts.

CONCLUSION

The petition for rehearing should be granted and is based on Rule 58 of Revised Rules of the Supreme Court of the United States, and upon the principle laid down in the case of Schriber-Schroth Co. v. Cleveland Trust Co., 305 U.S. 47, 50.

CERTIFICATE

I, PERCY C. HECKENDORF, certify that the Supplemental Argument in Support of Petition for Writ of Certiorari is based upon Rule 58 of the Revised Rules of the Supreme Court of the United States and is presented in good faith and not for delay, and is restricted to the grounds set forth in paragraph 2 of said Rule and the principle in the case of Schriber-Schroth Co. v. Cleveland Trust Co., 305 U.S. 47, 50.

PERCY C. HECKENDORF
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